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IN THE

Supreme Court of the United States

OCTOBER TERM, 1970

No. 338

BLONDER-TONGUE LABORATORIES, INC.
Petitioner,

v.

UNIVERSITY OF ILLINOIS FOUNDATION, et al.,
Respondents.

On Writ of Certiorari to the United States Court of Appeals for the Seventh Circuit

APPENDIX TO THE BRIEF FOR THE AMERICAN PATENT LAW ASSOCIATION AS AMICUS CURIAE

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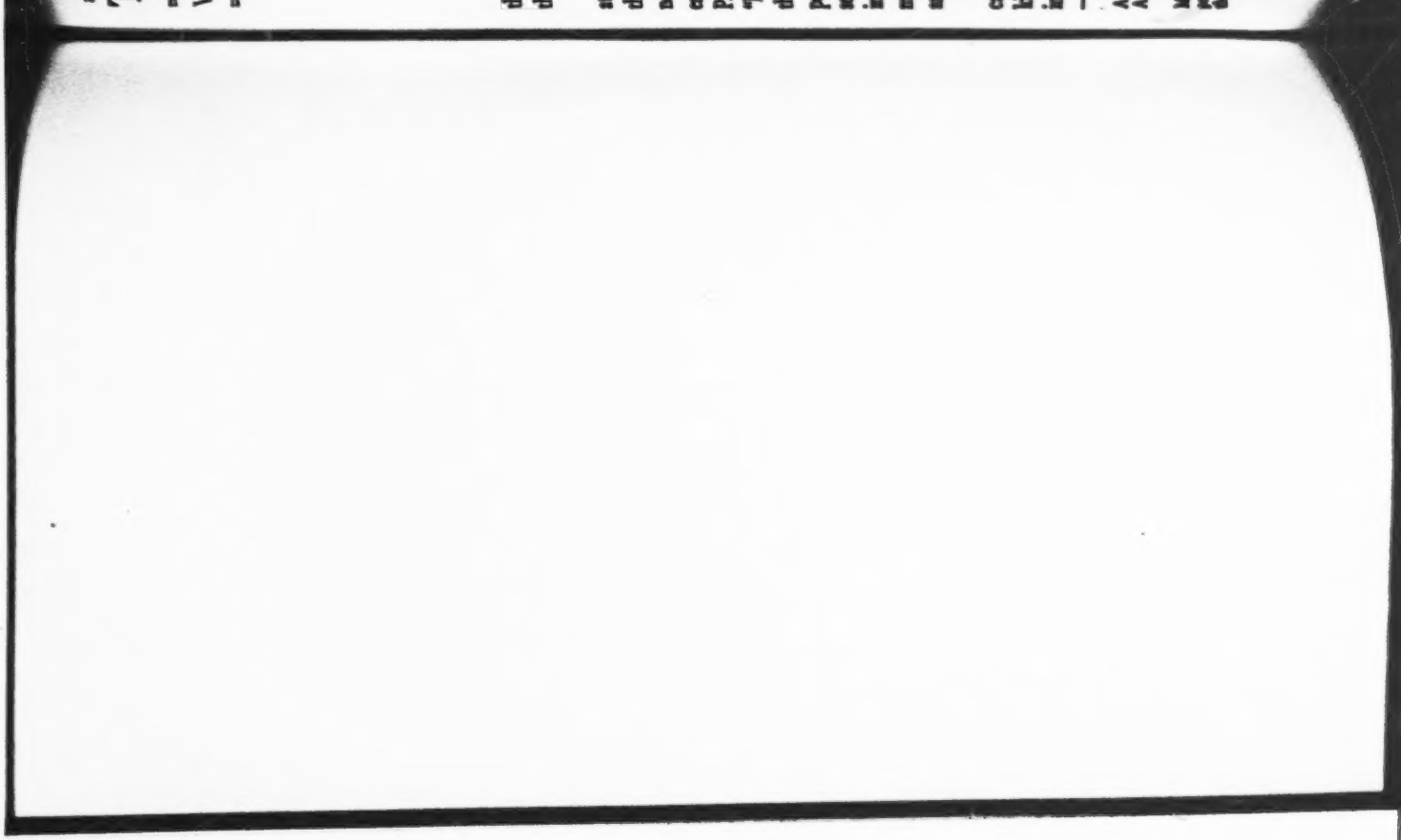

The George Washington Law Review

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PRINCIPLES OF PATENTABILITY*

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Associate Judge
United States Court of Customs and Patent Appeals

I. INTRODUCTION

The stimulus for the ensuing discussion is a recent encounter with the unsound notion that to be patentable an invention must be better than the prior art.

What are the statutory requirements for patentability? Looking at the Patent Act of 1952,[1] wherein all of the statutory and much of the case law on the subject has been gathered together, revised, and newly arranged in an orderly fashion, we find a division of the statute entitled "PART II—PATENTABILITY OF INVENTIONS AND GRANT OF PATENTS."[2] The first chapter thereunder, chapter 10, is entitled "Patentability of Inventions" and therein one would expect to find the answer to the question: "What are the statutory prerequisites to patentability?" There are five sections in that chapter. The first, section 100, is a definition section, to clarify and establish the meanings of the terms used, and the last, section 104, deals with inventions made abroad. Ignoring the special problems of the latter situation, we are left with three sections dealing with patentability.

Section 101, entitled "Inventions patentable," enumerates the categories of inventions subject to patenting. Of course, not every kind of an invention can be patented. Invaluable though it may be to individuals, the public, and national defense, the invention of a more

*Reproduced substantially as presented in speeches to the Rochester Patent Law Association, Rochester, N. Y., September 28, 1959, and The Dayton Patent Law Association, Dayton, Ohio, December 11, 1959.

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[1] 35 U.S.C. §§ 1-293 (1958).

[2] 35 U.S.C. §§ 100-188 (1958).

effective organization of the materials in, and the techniques of teaching a course in physics, chemistry, or Russian is not a patentable invention because it is outside of the enumerated categories of "process, machine, manufacture, or composition of matter, or any new and useful improvement thereof." Also outside that group is one of the greatest inventions of our times, the diaper service. Section 101 lays down too, with respect to all categories of patentable inventions, the basic requirements of novelty and utility.

Sections 102 and 103 both have headings which commence with the words "Conditions for Patentability." Section 102 adds the subheading, "novelty and loss of right to patent" and deals, primarily, with what is known in this field of law as "prior art" and "statutory bars," stating the legal conditions pertaining to the novelty which is required by section 101. Section 103 adds the further condition, well-described in its subheading as "non-obvious subject matter," about which more will be said later on.

From sections 101, 102, and 103, therefore, we get the trio: novelty, utility, and unobviousness, referred to prior to the 1952 Patent Act—and unfortunately still generally referred to—as novelty, utility, and "invention."

Whichever way we express the prerequisites to patentability, where do we find any requirement that the invention must be *better* than the prior art? Yet we frequently read or are told, and some court opinions have said, that unless an invention is better than the prior art it is not patentable. If one asks what basis there is in the law for such a proposition, the usual answer will be, "Why, it is required by article I, section 8, clause 8 of the Constitution, the fundamental basis of all our patent law." This proposition will now be examined.

II. Constitutional Basis of Patent Law

The brief and familiar words of the Constitutional clause say:

> The Congress shall have Power: . . . .
> To promote the Progress of *Science and useful Arts*, by securing for limited Times to *Authors and Inventors* the exclusive Right to their respective *Writings and Discoveries*.[3]
> . . . .

[3] U.S. Const. art. I, § 8, cl. 8. (Emphasis added.)

> To make all Laws which shall be necessary and proper for carrying into Execution the foregoing Powers.[4]

This certainly does not *say* that Congress has the power to secure to an inventor the exclusive right to his discovery only if it is better than what was known to the art. It just says that Congress has the *power* to secure exclusive rights to inventors for a certain purpose, namely, "To promote the progress of . . . useful Arts." To that end it is left to Congress to make, or not to make, the laws in implementation of the authority granted.

It is reasonably predictable that the last statement will be questioned on the ground that the constitutional purpose behind the patent system is, "To promote the progress of Science and useful Arts," but that would be a misconstruction. Let us digress for a moment to consider this point. To say that the purpose of the patent system is to promote the progress of science and useful arts involves an erroneous reading of what is actually written in the Constitution. Many people have been so conditioned by reading the constitutional clause uncritically, and by reading the plethora of judicial opinions reiterating the phrase, "To promote the progress of Science and useful Arts. . . ." that they have come to think that that is the purpose of the patent system.

It is unnecessary here to go into great detail about what the constitutional clause quite clearly says, once its true meaning has been revealed, as the subject has been thoroughly explored by Karl B. Lutz in his article entitled "Patents and Science, A Clarification of the Patent Clause of the United States Constitution."[5] Moreover, he was not the first in modern times to explain the matter as he takes his basic concept from DeWolf's *An Outline of Copyright Law*[6] published 24 years earlier. The conclusion they both reached is here recapitulated.

Clause 8 of article I, section 8 is a "balanced" sentence dealing with two distinct subjects, now known as copyrights and patents. It refers to them alternately, along with what is related to them.

What is to be promoted? "Science and useful Arts."

Who is to get rights? "Authors and Inventors."

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[4] U.S. Const. art. I, § 8, cl. 18. (Emphasis added.)

[5] 18 Geo. Wash. L. Rev. 50 (1949).

[6] Dewolf, An Outline Of Copyright Law 15 (1925). Mr. DeWolf, now deceased, was at one time Acting Register of Copyrights.

In what are the rights? "Writings and Discoveries." The clause was a consolidation of two proposals which got packaged together. One was to grant copyrights to authors. The other was to grant patents to inventors. Both involve rights to exclude and were recognized forms of lawful monopolies. Neither was a new idea. They were both known in England and the colonies. Now they were being made the subjects of delegated powers. Congress was given power to promote the progress of "science" not by protecting inventors, but by securing to authors exclusive rights to their writings. What was meant by "science" in that context? It meant knowledge in any field and it included all fields. Dr. Samuel Johnson's Dictionary,[7] contemporaneous with the Constitution, defines "science" as:

1. Knowledge
2. Certainty grounded on demonstration
3. Art attained by precepts, or built on principles
4. Any art or species of knowledge

> I present you with a man Cunning in music and mathematicks, To instruct her fully in those *sciences.*
>
> *Shaksp.*

5. One of the seven liberal arts, grammar, rhetorick, logick, arithmetick, musick, geometry, astronomy.

> Good sense, which only is the gift of heaven, And, though no *science*, fairly worth the seven.
>
> *Pope.*

The Oxford Dictionary of 1914[8] indicates that in *modern* usage the word "science" is often treated as synonymous with the natural sciences. An illustration from literature under the date 1884 quotes a writer as saying:

> I remember him years ago as a logic and *science* coach. I don't mean for cutting up cats, but what *science* meant then, Ethics, Butler, and such like.[9]

A reference to Dr. Johnson's definition of "scientifick" will show, furthermore, that the natural science which the present connotation of

[7] JOHNSON, ENGLISH LANGUAGE DICTIONARY (1st Amer. ed. 1818).

[8] A NEW ENGLISH SCIENCE DICTIONARY, definition 5b (Murray ed. 1914).

[9] *Id.* at definition 5c.

the word calls to mind was, in the days when the Constitution was written, referred to as "natural philosophy." "Science" meant knowledge;[10] "scientifick" meant producing demonstrative knowledge, producing certainty;[11] and "scientifically" meant in such a manner as to produce knowledge. The promotion of science in this sense was something Congress was empowered to do by the protection of the writings of authors.

The other and separate objective was to promote "useful Arts" and Congress was empowered to do this by protecting the discoveries of inventors. If the promotion of both "Science and useful Arts" be ascribed as the object of the patent system, then the copyright system would have no stated object.

The authors of the first patent act, which was presented to Congress on February 16, 1790,[12] in the second session of the first Congress, understood the distinction. That act was entitled, "An Act to promote the progress of useful arts." So were the subsequent acts of 1793,[13] 1794,[14] and 1836.[15] By contrast, the copyright law of 1790,[16] was entitled, "An act for the encouragement of learning." The only word in the constitutional clause corresponding to learning is "science."

By some peculiar slip, the 1837 patent act[17] was entitled "An Act in addition to the act to promote the progress of science and useful arts," but there was no such act thus entitled! The 1839 act,[18] in its heading, corrected the mistake, which was never made again.

When the bill which became the Patent Act of 1952[19] was submitted to Congress, the usual House[20] and Senate committee reports[21] were submitted with it and therein were concise statements of the point just discussed. As a matter of legislative history therefore, the clear intent of Congress was, as always, to promote progress in "useful Arts."

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[10] Johnson, *op. cit. supra* note 7.
[11] Johnson, *op. cit. supra* note 7.
[12] 1 Stat. 109 (1790).
[13] 1 Stat. 318 (1793).
[14] 1 Stat. 393 (1794).
[15] 5 Stat. 117 (1836).
[16] 1 Stat. 124 (1790).
[17] 5 Stat. 191 (1837).
[18] 5 Stat. 353 (1839).
[19] H.R. 7794, 82d Cong., 2d Sess. (1952).
[20] H. R. Rep. No. 1923, 82d Cong. 1st Sess. 4 (1952).
[21] S. Rep. No. 1979, 82d Cong., 2d Sess. 3 (1952).

III. Advancement of the Art Concept

Returning to consideration of the proposition—that to be patentable an invention must be better than the prior art, clearly no support for it is to be found in the present statutes. There was once a provision which seemed to imply that the Commissioner had authority to pass on relative superiority.[22] It last appeared in R. S. 4893 and it said that the Commissioner of Patents might issue a patent on an application if it appeared to him, first, that the applicant was justly entitled to it under the law and second, if it appeared to him that the invention "is sufficiently useful and important." This was a strange mixture of concepts, the applicant's right to a patent under the law and the Commissioner's simultaneously existing power to withhold it; the latter clause does not appear in the 1952 act. The revision note says that it was omitted "as unnecessary, the requirements for patentability being stated in sections 101, 102, and 103."[23] The Federico Commentary on the New Patent Act adds the following:

> The meaning of this old phrase was obscure and it has seldom been resorted to either in the Patent Office or in the Courts.[24]

The old phrase, "sufficiently useful and important," was in fact deleted because of the possibility that, although disused and moribund, it might be construed as imposing some limitation on the statutory requirements for patentability over and above the requirements of sections 101, 102 and 103.[25] With this deletion, the corresponding section of the 1952 act, section 131, provides only that if the Commissioner's examination of an application shows that the applicant is entitled to a patent *under the law*, he shall issue a patent. The law is now all in the statute—conceding that it has to be construed and applied[26]—and nowhere do the statutes say an invention must be better to be patentable.

What if any support for the contention that a requirement that an invention to be patentable must be better than the prior art is to be found in the Constitution? If any is to be found there, it must lurk either in the phrase "To promote the progress of . . . useful Arts" or in the words "Inventors" and "Discoveries."

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[22] 1 Stat. 110 (1790); 5 Stat. 120 (1836); Rev. Stat. § 4893 (1875).

[23] 35 U.S.C.A. § 131 revision note (1954).

[24] Federico, *Commentary on the New Patent Act* in 35 U.S.C.A. § 1 at p. 36 (1954).

[25] Writer's personal knowledge as one of the drafters of the Patent Act of 1952.

[26] Lyon v. Bausch & Lomb Optical Co., 224 F.2d 530, 535 (2d Cir. 1955).

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Let us consider first "progress in the useful arts." How is such progress actually made? For one thing it is made by the constant increment of improvements on what we already have, produced both by the expected skill of ordinary workers in the arts and by the unobvious developments which would not occur spontaneously from the application of such ordinary skill. The former improvements are never patentable. Why? Because they will be made anyway, without the "fuel of interest" which the patent system supplies. The unobvious improvements, if new and useful, are patentable if proper steps are taken, and the bulk of issued patents are probably granted for this class of inventions.

In contending for the patentability of such improvement inventions, attorneys get used to arguing that they are patentable by pointing out how they *are* better than the prior art. An "improvement" is, by definition, necessarily better. On the other side, the Patent Office examiners get so used to these arguments that they come to expect them, indeed to ask for them, and some examiners are inclined to insist on their rejections when they are not forthcoming. But have they any legal right to insist on proof or convincing argument that an invention is better? Is it a proper ground of rejection to say that an invention is no better than the prior art? Analysis will show it is not.

Progress in useful arts is made as well by what may be called enrichment as it is by improvement, by the duplication of means for doing any given job. The patent system, by its very nature tends to promote this kind of progress for as soon as a patented device, for example, meets with popular demand, forces are set in motion to design around the patent, to avoid infringement and at the same time produce another device to do the same job, preferably just as well or better. Take the case, however, where the new device is not only no better but not quite as good, or even recognizably inferior but possibly cheaper to make.

To illustrate the point without particular reference to patentable inventions, consider the progress made as a result of that cheap, inferior, rattletrap Model T Ford which, according to some points of view, was inferior to every other automobile on the market. But people began going places and a new era was born. For that matter, as means of transportation suited to the times, were the first automobiles actually better than the horse?

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Who is to say which is best as between the Mimeograph, the Ditto, the Multigraph, Mutilith, Thermofax, Photostats, Photo-Offset, Verifax, Xerography and other systems of like nature? Has no real progress been made in the usful art of reproduction because we have these alternative means? Useful arts which start out by being competitive end up by cross fertilizing each other as the telegraph, the telephone and radio have borrowed from and supplemented each other.

At the inception of the talking pictures industry, which was better, sound-on-film or sound-on-disc? At the time of the first commercialization both had been invented but the discs were first used because those making the choice thought they were better. Today they are all but obsolete and sound-on-film prevails; but to be commercially practicable and better than discs it had to await development of auxiliary equipment. How could a patent examiner pass judgment on such a matter at a time when the industry itself did not know the answer?

We need not confine ourselves to thinking about invention on the grand scale. In the remote corners of the most crowded arts, progress is made by the proliferation of ideas, different and unobvious ways of doing the same thing, so that the reservoir of inventions fills up. It should never be forgotten that *patented* inventions are published and become a part of the technical literature. This publication itself promotes progress in the useful arts and it is the prospect of patent rights which induces the disclosure and the issuance of the patent which makes it available. Whenever novel subject matter, unobvious to the workers of ordinary skill in an art, is published, progress in the art is promoted. The literature of the art is enriched, another way of doing something is made known and even if it be inferior to the means already known, there is no telling when it may give another inventor an idea or when someone will improve on it in such a way as to surpass all that is known. Everyone can learn from mistakes, including the mistakes of others, provided he can find out about them. *Patents* or inventions that have failed can promote progress. Abandoned applications cannot.

The patent system does not promote progress merely by rewarding those who succeed commercially. It promotes it by stimulating inventive activity, by bringing about a disclosure of the results of that activity, and by encouraging investment in the production and

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marketing of inventions as well as in research and development. It is not to be expected that everything which this stimulus succeeds in producing will be of equally good quality.

The situation is comparable to the effects of the copyright system. The stimulus it gives to the production of literature, art, and music is bound to produce the bad along with the good. So is it in the patent system, but by producing the whole lot you get the good. There is no way to get cream without producing milk. Retard milk production and you will get less cream.

A serious objection to the notion that an invention must be better to be patentable is that it would require the Patent Office and the courts reviewing its final rejections to make a value judgment of a kind they are not equipped to make and should not be asked to make. Patent applications must as a rule be made and examined soon after the invention is made. At this stage who can tell whether an invention is better? Of what use is a new born baby? Many are the inventions which cannot be tried out except by putting them on the market and which nobody will risk putting on the market unless there is patent protection. Without the test of time it is often impossible to say what is better and what is worse, which is important and which is not important. The sort of commercial success, evidence of which is produced in infringement suits, which may demonstrate that an invention is better, occurs only after the invention has proved itself in the market place. Such evidence is not in existence at the patenting stage except in unusual cases. This is a cogent reason why the patent issuing agency should not have the power to pass on the question of relative superiority or to demand evidence of it as a prerequisite to patentability.

To do the job of promoting progress, the incentives afforded by patent protection have to be maintained to the point where they will encourage production, even of things that patent office examiners may think are inferior. They could be wrong and the inventor should have his chance. The marketplace will pass judgment. If that judgment goes against the patentee, as it frequently does, even with respect to inventions which look good to the patent office, there has been no loss to the public. It is difficult to understand the attitude of those who feel that *ideally* a patent should be granted only for the meritorious invention which is capable of being a commercial success. Patents are not Nobel or Pulitzer prizes! They are not for *exceptional*

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inventors but for average inventors and should not be made hard to get. True, they are temporary monopolies, but therein alone lies their power as inducements to invent, to disclose, to invest, and to design around. Why must an invention be a commercially hot number to be patentable? If it is a total dud, how is the public injured by a patent on it? A monopoly on something nobody wants is pretty much of a nullity. That is one of the beauties of the patent system. The reward is measured automatically by the popularity of the contribution. People don't get excited about the copyright monopoly on last year's newspapers, yet it is just as complete a monopoly and lasts much longer. The only possibility of doing damage is so to construe a patent on a dud as to cover a commercially meritorious invention made by a more competent inventor, but it is not noticeable that courts have a tendency to do that.

To sum up on whether the promotion of progress clause requires that inventions be better than the prior art to be patentable—clearly it does not. Progress is most effectively promoted by protecting those who enrich the art as well as those who improve it. Even though their inventions are not as good as what really exists, such inventors are not being rewarded for standing still or for retrogressing, but for having invented something. The system is not concerned with the individual inventor's progress but only with what is happening to technology. It is advanced by every new thing contributed to it, whether or not that thing by itself is better at the time of its creation.

IV. Limitation on Patentability

Of course, not every new contribution, even within the statutory categories, should be patented, and there is the question of where to draw the line. This we can consider in the course of discussing the words "Inventors" and "Discoveries" in the constitutional clause. They certainly have had an effect on the decisions of the courts as to what inventions are patentable. At least, they have frequently been used in rationalizing decisions on patentability.

As long ago as the Act of 1793, there was a declaration that "simply changing the form or proportions of any machine, or composition of matter, in any degree, shall not be deemed a discovery."[27] Be-

[27] 1 Stat. 321 (1793).

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hind this there was apparently an assumption that if the inventor had not made a "discovery," he was not entitled to a patent.

The word "Inventors" appears also to have been seized upon at an early date as a basis for saying that to have anything patentable, there must in fact be an "invention." Since, in the early acts, the words, "invention" and "discovery" were used interchangeably, we have evidently had from the very outset of our patent system a working rule that no patent would be granted unless there was what was deemed to be an "invention" or "discovery." This led to all sorts of semantic difficulties, for the word "invention" thus came to be used to refer to the thing invented and also to some vague quality necessary to patentability.

In the papers of Thomas Jefferson, who was a member of the first patent "Board" which granted patents, is a proposed revision of the 1790 act, in which he suggested adding the statutory defense that, "The invention is so unimportant and obvious that it ought not to be the subject of an exclusive right." [28] He clearly comprehended that one might have invented something, and hence have *an* invention, which was nevertheless unpatentable. He spoke with greater clarity than most of his successors who fall into the "lack of invention" jargon.

It has generally been stated to be the law that, in addition to being new and useful, an invention, to be patentable, must involve "invention." Merely to state that proposition, in the absence of an initiation into the mysteries, sounds ridiculous. A neophyte might well ask, "What do you mean, an invention must involve invention?" The sophisticates would answer saying, " 'Invention,' the Supreme Court has held 'cannot be defined.' [29] It is 'that impalpable something' which you must have to get a patent. Experienced patent lawyers, the Patent Office, and the courts understand what it means, only they never agree."

The various meaningless phrases which have been used to express this essential mystery—something akin to a religious belief—are familiar to everyone:

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[28] Draft of a Proposed Bill To Promote the Progress of the Useful Arts in 5 THE WRITINGS OF THOMAS JEFFERSON, 1788-1792 at 279 (P.L. Ford ed. 1895). This proposed bill was drafted by Jefferson, and introduced into the House of Representatives Feb. 7, 1791, by White. *Id.* at 278 n.1.

[29] McClain v. Ortmayer, 141 U.S. 419, 427 (1891).

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Patentable novelty, or simply patentable invention.[30]
Exercise of the inventive faculty,[31] the creative faculty,[32] inventive skill,[33] or inventive effort.[34]
The creative work in the inventive faculty.[35]
A substantial invention or discovery.[36]
The flash of creative genius.[37]

Very recently a Louisiana District Judge charged a jury that the status of invention is achieved only when "something new, unexpected *and exciting*" [38] results—that, in an automobile transmission!

No one could operate exclusively by such indeterminate standards and so a whole series of negative rules for testing the existence of "invention" evolved, such as "mere rearrangement of parts does not *normally* amount to 'invention,' " and to each of these rules well-founded exceptions developed in the case law.

In the final analysis, all it amounted to was that if the court thought the invention, though new and useful, was not patentable, then it did not involve "invention" and vice versa. The requirement for "invention" was the plaything of the judges who, as they became initiated into its mysteries, delighted to devise and expound their own ideas of what it meant; some very lovely prose resulting.

In the course of the long struggle with that obscure requirement that to be patentable an invention must involve "invention" or, stated another way, that an invention must *really* be an invention or a discovery, untold quantities of argument have been submitted to the Patent Office and the courts in an effort to show that "invention" was present, bearing on the alleged superiority of the thing invented over the prior art. Where there has been success in obtaining or sustaining a patent, it has often been argument along these lines which has

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[30] United Chromium, Inc. v. International Silver Co., 53 F.2d 390, 393 (D. Conn. 1931), *aff'd* 60 F.2d 913 (2d Cir. 1932).

[31] Potts v. Creager, 155 U.S. 597, 608 (1895).

[32] Hammond Buckle Co. v. Goodyear Rubber Co., 58 Fed. 411, 413 (2d Cir. 1893).

[33] Ansonia Brass & Copper Co. v. Electrical Supply Co., 144 U.S. 11, 18 (1892).

[34] Smith v. Goodyear Dental Vulcanite Co., 93 U.S. 486, 497 (1876).

[35] Hollister v. Benedict & Burnham Mfg. Co., 113 U.S. 59, 73 (1885).

[36] Atlantic Works v. Brady, 107 U.S. 192, 200 (1882).

[37] Cuno Engineering Corp. v. Automatic Devices Corp., 314 U.S. 84, 91 (1941).

[38] The appeal court, while reversing on other grounds, said:
In the total context we do not regard this as harmful but we do feel that this was an unfortunate choice of words for the Trial Court to use in describing the standard of invention.
Thurber Corp. v. Fairchild Motor Corp., 270 F.2d 841, 849, 122 U.S.P.Q. 305, 311 (5th Cir. 1959).

succeeded. However, it does not logically follow from the fact that a thing which *is* better than the prior art is patentable, that to be patentable a thing *must be* better. The words "Inventors" and "Discoveries" no more dictate that an invention must be better than does the promotion of progress clause. The Constitution, therefore, contains no such requirement.

To conclude on this question of patentability, there are some things about the Patent Act of 1952 which neither the bar nor the courts seem to have fully comprehended. The bar, of course, takes up opposite sides and confuses the courts, so the courts may be forgiven for taking so long to reach *Lyon v. Bausch & Lomb*,[20] the first opinion, thanks to the perception of Judge Learned Hand, to express clearly what was actually in the minds of the drafters of the act.

With respect to what *used* to be called the requirement of "invention"—and the use of the past tense in referring to it cannot be too strongly urged—the 1952 act did three things:

1. *It put the requirement into the statutes for the first time, in section 103.* The "sufficiently useful and important" clause in R. S. 4893 never seems to have been regarded as the true basis for the requirement of "invention," which was treated as the creation of the courts. Though one may call section 103 "codification" it took a case law doctrine, expressed in hundreds of different ways, and put it into statutory language in a single form approved by Congress. In such form it became law superior to that which may be derived from any prior court opinion.

2. *The Patent Act of 1952 expresses this prerequisite to patentability without any reference to "invention" as a legal requirement.* Nowhere in the entire act is there any reference to a requirment of "invention" and the drafters did this deliberately in an effort to free the law and lawyers from bondage to that old and meaningless term. The word "invention" is used in the statute only to refer to the thing invented. That is why the requirement of "invention" should be referred to, if at all, only with respect due to that which is dead.

3. *The act sets as the standard of patentability the unobviousness of the invention, at the time it was made, to a person having ordinary skill in the art.* Therefore, what we have today, and have had since January 1, 1953, is a requirement of *unobviousness*, rather than a requirement of "invention." (It is assumed, of course, that the in-

[20] Lyon v. Bausch & Lomb Optical Co., *supra* note 26.

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vention is new and useful and has not run afoul of any statutory provisions such as a statutory bar.)

The question will, of course, be asked, "What difference does it make, it must still be a subjective decision?" True, but now the statute provides a standard according to which the subjective decision must be made. There is a vast difference between basing a decision on exercise of the inventive or creative faculty, or genius, ingenuity, patentable novelty, flashes, surprises and excitement, on the one hand, and basing it on unobviousness to one of ordinary skill in the art on the other. It is possible to determine what art is involved, what type of skill is possessed by ordinary workers in it, and come to some conclusion as to what "ordinary skill" would be at a given time. This may present knotty problems but it is a definite pattern of thinking and does not leave the Patent Office or the courts free to conclude that a thing is not patentable for any old reason and then stand on the proposition that something indefinable and impalpable called "invention" was not involved. At least they have to talk in terms of obviousness to a man of ordinary skill in the art. While the ultimate decision as to what his skill would be and what would be obvious to him is subjective, it is one definite proposition on which evidence can be adduced. The best the courts could do in the past was to assume, under certain sets of circumstances such as the existence of a long-felt want and an immediate market acceptance of an invention, that there must have been "invention." This was nothing but a labeling process, like calling unpatentable combinations "aggregations" and public use that should not be a bar "experimental use."

The law then is that inventions within the statutory categories which are new, useful, and unobvious are patentable to inventors who proceed in accordance with the statutes.

We have come a long way in understanding our own patent system since 1790 and we have learned a lot about how to express the principles according to which it operates. We have gotten rid of the 1790 expression of the patent right, for example, which was stated in the statute to be "the sole and exclusive right and liberty" [40] of practicing the invention and the more recent but also misleading "exclusive right to make use and vend," [41] substituting the simple

[40] 1 Stat. 109 (1790).

[41] 16 Stat. 201 (1870).

and accurate "right to exclude others from making, using, or selling," [42] which is and always has been the patent right.

The drafters of the present statute did their best to take out of the law the undefinable concept of "invention." Whether lawyers will now take advantage of the terminology which has been provided and stop talking nonsense is up to them.

[42] 35 U.S.C. § 154 (1958).

THURSDAY EVENING SESSION

Kettering Award Address

THE VAGUE CONCEPT OF "INVENTION" AS REPLACED BY § 103 OF THE 1952 PATENT ACT

JUDGE GILES S. RICH

An address delivered by Giles S. Rich, Judge of the United States Court of Customs and Patent Appeals, at the Award Dinner of the Eighth Annual Public Conference of The Patent, Trademark, and Copyright Research Institute on June 18, 1964. Judge Rich received the Institute's seventh annual "Charles F. Kettering Award for Meritorious Work in Patent, Trademark, and Copyright Research and Education."

I believe in incentive systems. Over 20 years ago a prize competition lured me into some intense study and writing[1] which, through a traceable chain of events, has led to my being here tonight.

I did not win the prize. Neither did the other contestants, save one.[2] But they all contributed something. That is the way incentive systems work. They bring out all kinds of efforts, excellent, good, mediocre, indifferent, and bad. But the *system* brings forth the effort. Society benefits from the good and mediocre, as well as the excellent, efforts. The bad efforts don't hurt it any. They may even prevent others from making mistakes if they are made known.

The patent and copyright laws create such incentive systems. The copyright laws provide an incentive which brings out the greatest works of literature and art as well as a lot of trash. The patent system works in a similar way. But you can't get cream without producing milk and, anyway, it is the milk that society lives on.

I don't suppose you will be surprised if I talk about the patent system. The aspect of it I will talk about is the one I think causes the most trouble, the clarification of which I therefore believe would do the most good.

As groundwork I will first state an axiomatic but too-little-thought-of principle. A monopoly merely gives rise to *power* which can be put to either good or bad uses. Hence, in the case of monopolies

[1] The Linthicum Foundation Competition, 1941, Dean John H. Wigmore, Northwestern University Law School, Chairman. The writer's contribution was published in five installments in the *Journal of the Patent Office Society*, Vol. 24, pp. 85, 150, 241, 328, and 422, commencing Feb. 1942.

[2] The winner was Laurence I. Wood whose paper was published in book form, 1942, by Commerce Clearing House, Inc., under the title *Patents and Antitrust Law*.

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created by government grant, which is all patents are so far as the rights they create are concerned,[3] we have to distinguish between good and bad monopolies.

I will take two well-known examples from history. First, the bad monopoly. Queen Elizabeth granted to one Darcy, a member of her court, a monopoly of playing-cards for 21 years so that he could make some money. But playing-cards were old and well-known and others were making a living from making and selling them in England. This monopoly, which was by Royal Letters Patent, therefore took from the public a freedom in business which it had long enjoyed before the patent; and it was bad.[4]

In Venice in 1594 the Doge, on behalf of the government, granted to the great Galileo a "privilege," which was the Venetian name for a patent, on a machine which he had *invented* "for raising water and irrigating land with small expense and great convenience," on the condition that it had never before been thought of or made by others.

Galileo made a couple of significant remarks in his petition for the privilege. He said, "it not being fit that this invention, which is my own, discovered by me with great labor and expense, be made the common property of everyone;" and also, that if he were granted the privilege, "I shall the more attentively apply myself to new inventions for universal benefit." In short, he was not inclined to divulge his invention only to have it copied; but if the government would give him some reasonable protection he would not only divulge it and build it but might even apply himself to making some more inventions. Deeming this to be a *good* use to which to put a limited mon-

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[3] Dean Wigmore, n. 1, in his foreword to the Wood book, n. 2, said:

"... I take the opportunity to intrude my personal opinion, that neither Courts nor treatise-writers have been radical enough in defending the legitimacy of the "monopoly" in a patent, as distinguished from the ordinary trade-monopoly. Is it not a fact that every property-right we have is a "monopoly"? The right to our house or our automobile is simply a right to keep anyone else from entering or using it without our consent; and is that not a monopoly?

* * * *

Of course patent-rights can be so *used* as to merit the distrust attaching to a monopoly,—by contracts fixing prices, by tying agreements, by pools and the like. But so can gold-mines and all the necessities of life by bargains be used monopolistically; yet no one blames the mine-owning right itself or the food-ownership right itself; the blame is directed to the use of it.

And so I for one regard it as unfortunate that courts and treatise-writers have not stood up more boldly for the fundamental right-ness of the patent right itself. I say "for one", because I do not recall reading anywhere an adequate defense of the theory of the patent-right.

[4] Darcy v. Allin, 11 Co. Rep. 846; 1 W.P.C. 1. See *Monopolies and Patents* by Harold G. Fox, U. of Toronto Press, 1947, p. 318. The case also has the popular title "The Case of Monopolies."

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opoly, the Council voted to grant him a "privilege" or patent of monopoly for 21 years.[5]

The Venetians were accustomed to doing this, having granted about 1600 "privileges" in the 15th and 16th centuries.[6]

The English in 1624 enacted a statute[7] abolishing and prohibiting future monopolies of the bad Darcy sort and authorizing the continuing grant of Letters Patent for new inventions within the realm, which has continued to this day.

The founding fathers came to America from the mother country, bringing with them knowledge of this practice of granting monopolies. In the nearly 150 years of the colonial period preceding the Federal Constitution, the colonies and then the States granted numerous patents for new inventions as well as monopolies to encourage the founding of new industries, including, as the English did, encouragement of setting up in America industries already practiced abroad.[8]

It is not surprising that, when it came to the writing of a Constitution, provision should be incorporated, with no controversy at all, for Congress to make laws for the granting of patents to inventors, or that George Washington should urge its speedy enactment, or that the very first Congress should enact our first Patent Act of 1790.[9]

Then began our patent system. One might describe it as a great experiment which goes on continuously, getting more complex all the time, in which this Institute is playing, for the first time, a vital roll in finding out how the system actually works, as an aid to preserving its basic principles and saving the obvious good that is in it.

In this experiment, which involves a mixture of economics, law, technology, and psychology, we still have the centuries-old problem of monopoly power being utilized for socially good and socially bad ends and of deciding which is which.

The greedy nature of some men is such that there are always pressures toward the creation of bad monopolies. Undue preoccupation with countering this pressure, however, has quite blurred the vision of many well-intentioned but not too well-informed people to the good uses monopoly can be put to and to the good that monopoly

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[5] *Journal of the Patent Office Society*, Centennial Number, "History of the Patent Office," July 1936, Vol. 18, p. 23.

[6] *Id.* Most of the privileges were for copyrights but a small percentage were for inventions.

[7] The Statute of Monopolies, May 25, 1624, 21 Jac. I, c. 3. For its history see Fox, *supra*, n. 4, Chap. IX, pp. 113-126.

[8] See *JPOS*, *supra*, n. 5, pp. 35-58.

[9] *Id.* pp. 55-62.

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power can do, properly channeled and not so proscribed as to lose its effective power.

Paradoxically, in the working of the patent system, monopoly often promotes competition. Numerous instances are all around us, wherever two products serving the same general purpose have achieved, with the aid of patent protection, commercial production. And only after such production is there any possibility of market competition.

To this point I have taken note that the *primary* distinction between good and bad patent monopolies is that the good patent does not monopolize something the public *already has*, so as to take something away from the public. The invention covered by the good patent must be *new;* and so our statutes have always provided, though the provision was not always enforced.[10]

But beyond bare novelty one must go one further and troublesome step to have a sound system and keep the monopoly on the good side.

As we refrain from granting patents on inventions that are not new, we must also refrain from granting patents on those inventions which would arise *spontaneously*, given the need or the desire for them, as the yelp of the dog surely follows from stepping on his tail, or with *only a nominal expenditure of time, effort, money or wit*—especially if the invention is one of real utility likely to meet with popular demand.

It was not long after the Patent Act of 1836—in 1850 in fact—that the United States Supreme Court made this clear in the "doorknob case," *Hotchkiss* v. *Greenwood*.[11] What was involved was the trial judge's charge to a jury that if *no more ingenuity or skill was required* to construct the patented doorknob *than was possessed by an ordinary mechanic acquainted with the business*, then the patent was invalid.

The Supreme Court approved the charge. The opinion said: "In other words, the improvement is *the work of the skilled mechanic, not that of the inventor.*" (My emphasis.) The decision made clear that patents are not to be granted on inventions which are no more than what the ordinary mechanic acquainted with the business would produce as a matter of course in the pursuit of his calling. Such mechanics are expected to produce *new* things, such as were involved in that case, which was the attaching of an old clay doorknob to an old metal shank in precisely the same manner that metal doorknobs

[10] *Id.* pp. 77-82, 230. Under the 1793 Act, for example, there was no examination for novelty over a period of 43 years. About 10,000 patents issued under that act for terms of 14 years, less than the number issued today in 3 months.

[11] 52 U.S. 248.

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had been attached to such shanks before. Technically the assembly was *new*, but the court found novelty was not enough.

In referring to "mechanics" in this matter we can take them to be representative of a class—all those with ordinary skill in the various callings, ordinary shoemakers, ordinary chemists, electronic technicians of ordinary skill, etc.

Due to the reasoning of the case, that the new doorknob "was the work of the skillful mechanic, not that of the inventor," what came out of it after 1850, and is still with us, was an injection into the law of what has ever since been called the "requirement for invention."

As is usual with a "doctrine" derived from a court opinion, the doctrine persists while the facts out of which it arose are forgotten. The opinion in the first case is quoted to the judge in a second and he does an opinion embroidering on it, his words being quoted in turn and reembroidered and so on.

I think the resulting situation with respect to the law on the "requirement for invention" was well summed up by Judge Learned Hand, who knew as much patent law as any judge ever has, at a Senate hearing in which your then Dean Colclough and I both participated in 1955, as follows:

"You could find nearly anything you liked if you went to the opinions. It was a subject on which judges loved to be rhetorical. • • • patent lawyers • • • like to quote all those things. There are lots of them." [13]

This proliferation of views on what did and did not amount to "invention" went on for 100 years. We were enlightened with the view that "invention" resulted from the exercise of the "inventive faculties" and other circular reasoning. Our present standard text, Walker, now in its seventh edition, says "An invention is the result of an inventive act." [14] Whole books on the patent law were written around such concepts. People collected the statements pro and con in volumes equally divided about in the middle—"invention" on one side, lack of it on the other. Negative and positive tests for detecting its presence evolved. So did exceptions to each test. And patent lawyers selectively quoted all of this mass of material as though it proved something. Judges like Learned Hand found, in his words, that "They never seemed to tend toward enlightenment." [15]

This requirement finally evolved into a *"standard* of invention"

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[13] Hearings pursuant to S. Res. 92, 84th Cong., 1st Sess., on the American Patent System, Oct. 10-12, 1955, p. 113.

[14] Walker on Patents, Deller Ed., Vol. 1, p. 110.

[15] Hearings, n. 12 *supra*, p. 113.

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which the courts pretended was being raised and lowered like an elevator as though it were something tangible. They also proclaimed in all seriousness—and are doing so this very summer—that this "standard" was to be found in the Constitution, where there are only two words on which it could possibly be predicated, the word "inventors" and the word "discoveries." [14a] You really have to be on the Supreme Court to find out a "standard" there because the only way it works is this: if you think the lower court was wrong in sustaining the patent, you proclaim that it applied too low a standard and reverse its decision.[15]

Some judges got it fixed in their minds that if a thing is an "invention" then it is patentable and if it is not patentable then it is not an "invention," not realizing that the same things are invented over and over—by the use of the inventive faculties or by inventive acts or what have you—and although clearly "inventions," their originators being as firmly convinced of it as was Galileo, they are not patentable for want of novelty. So it is customary for judges to approach all inventions gingerly in their opinions by referring to the, as "alleged" or "supposed" inventions.

All an invention is, however, is something which has been found out, or devised, or discovered. The question today is not what to call it but whether under the statute it is patentable. Hundreds of "real" or "true" inventions, all resulting from "inventive acts" and the exercise of the "inventive faculties," are held unpatentable every day for lack of novelty.

The Patent Office, of course, proceeded on the same basis, and still does so to a dwindling extent, rejecting applications for want of "invention" and granting them when it could be persuaded that "invention" was present. And through it all the patent lawyers and the judges persisted in telling all concerned that "invention" was something which could not be defined, like God! Patent validity came as a matter of grace, from on high. This was a messy state of affairs. The surprising thing is it worked so well. But not well enough.

[14a] I am not unaware of the statement of the *objective* in Art. I, sec. 8, clause 8, "To promote the progress of • • • useful arts." See "Principles of Patentability," 28 *Geo. Wash. L. Rev.* 393. When Congress exercised its power under that clause and set up a patent system, so long as the *system as a whole* functions to further the Constitutional objective, it would not seem that the statement of the objective could set any "standard" for patentability of any single invention.

[15] See Great Atlantic & Pacific Tea Co., v. Supermarket Equipment Corp., 340 U.S. 147, 87 *USPQ* 303 (1950), where the two concurring opinions below were held to have applied a "standard of invention • • • that is less exacting than that required • • •."

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In 1941 a Commission, appointed by President Roosevelt, and headed by Charles F. Kettering,[16] came out with a report which said:

"One of the greatest technical weaknesses of the patent system is the lack of a definitive yardstick as to *what is invention.* To provide such a yardstick and to assure that the various courts of law and the Patent Office *shall use the same standards,* several changes are suggested. It is proposed that Congress shall declare a national standard whereby [mark these words] *patentability* of *an* invention shall be determined by the objective test as to its advancement of the arts and sciences." [My emphasis.][17]

One apparent thought there was to stop talking about whether a thing is or is not an "invention," to take anything presented as an invention, and then to determine its *patentability* according to a standard which Congress was to declare, Congress never having said anything about it up to that time.

For some years nothing came of the Kettering Commission proposal but in the 79th, 80th, and 81st Congresses, from 1945 through 1949, identical bills were pending entitled, unfortunately but almost inevitably, "A bill to declare a national policy for determining invention." Now I have just said that the problem was not really to determine "invention," but to determine the *patentability of* inventions and this matter of language is one of major concern. Kettering got a hold on the distinction, but it keeps fading away like Alice's cat.

People don't think so much as they talk; and when they do think, they tend to think in words, at least about legal abstractions. Words are used to describe things, concepts, and experiences we have in common so that we can communicate. This thing, this concept, this experience every patent examiner, lawyer, and judge had come up against in practice was called the "requirement of invention," or just "invention"—the undefinable something or other that has to be there. This proves to be a cliché, meaningless though it is, that is hard to break away from. I taught for many years, and presumably my students learned, that the prerequisites to patentability were novelty, utility, and invention. There was nothing else to teach. Thinking and its concomitant words had not progressed beyond that point in the '30s and '40s. But today they have. Any current text-

[16] For a note on who Kettering was and his prolific accomplishments in the fields of business, research and inventing, see "The Kettering Archives" by Eugene B. Jackson, 44 *Jour. Pat. Office Soc.* 331, May 1964.

[17] Report of National Patent Planning Comm., June 18, 1943, H. Doc. 239, 78th Cong., pp. 6, 10.

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book and most cases, you will find, use the old terminology. But it isn't true any more and hasn't been for eleven and a half years—in my opinion, that is.

My not believing in ghosts or angels doesn't mean, *in law*, that there are no ghosts or angels, because if you think there are, and are frightened or informed by them, then they exist. As long as judges say there is a requirement for "invention," and many still do, then there is one. If you take a patent into court and the judge invalidates it for want of "invention" you *know* there is one. But why am I saying there is none? Am I talking theory or law; if law, then what kind of law? Or am I talking nonsense?

The outcome of those bills to determine invention, and one or two other bills, was that Congress got interested in revising and codifying the patent law and did so.[17a] In the new law (Title 35 U.S.C.) is a section, 103, described at the time by those who wrote it, at least in one place, as "incorporating a requirement for invention."[18] It was also described more carefully and accurately elsewhere[19] as providing a "*condition* which exists in our law and has existed for more then 100 years * * * by reason of decisions of the courts." (My emphasis.) And that "condition" is described in the title of this new section 103 as one for the existence of "non-obvious subject matter." The addition of section 103 was stated in the House Report on the bill[20] to be *one of the two major changes or innovations in the statute.*

What section 103 itself says is that what is patented must *not* have been *obvious* to one of *ordinary* skill *in the art involved,* at the *time* the invention was made. The parallel with what would be expected of the "ordinary mechanic acquainted with the business" in the "doorknob case" should be clear.

This is not a "standard of invention"; and it is not called a "requirement of invention." The presence or absence of "invention" is not mentioned. The use of the term "invention" was, in fact, carefully avoided with a view to making a fresh start, free of all the divergent court opinions and rhetorical pronouncements about "inventions."[21] And in doing that it was contemplated, as the House Report states,[22] that "This section should have a stabilizing effect and minimize great departures which have appeared in some cases."

[17a] See Giles S. Rich, "Congressional Intent—Or, Who Wrote the Patent Act of 1952?", in *Patent Procurement and Exploitation,* BNA 1963, pp. 61-78.

[18] House Report No. 1923, 82nd Cong., 2nd Sess., to accompany H.R. 7794, p. 5.

[19] *Id.* p. 7.

[20] *Id.* p. 5.

[21] The writer speaks from personal knowledge as one of the drafters.

[22] Note 18, at p. 7.

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As has been pointed out by one of the drafters of that section, Mr. Federico, in his Commentary,[23] what section 103 was gunning for was

"• • • some modification • • • in the direction of moderating the extreme degrees of strictness exhibited in a number of judicial opinions over the past dozen or so years; that is, that some change of attitude more favorable to patents is hoped for. This is indicated by the language used in section 103 as well as by the general tenor of remarks of the Committees in the reports and particular comments."

The real vice or inadequacy of the judge-made requirement for "invention" was in the truism Mr. Federico also restated, "the so-called standard of invention • • • is an unmeasurable quantity having different meanings for different persons." It left every judge practically scott-free to decide this often controlling factor according to his personal philosophy of what inventions should be patented, whether or not he had any competence to do so or any knowledge of the patent system as an operative socioeconomic force. This was too great a freedom because it involves national policy which should be declared by Congress, not by individual judges or even groups of judges on multiple-judge courts. In section 103 Congress made such a policy declaration. It did not there declare what should constitute "invention." It was a statement of something to take the place of this vague concept. And it was made in the face of judicial declarations, made in the *absence* of a statute, which Congress expressly desired to modify.

I would like to inject a new term into the language so we can discuss the matter rationally. I would like to call it the THIRD REQUIREMENT of patentability. The statute sets out all the requirements in the clearest possible form. Section 101 says inventions must be *new* and *useful*, requirements one and two; section 102 defines novelty; and section 103 lays down the *third requirement*. I repeat its clear-cut title: *"Conditions for patentability; non-obvious subject matter."*

Upon examination in the Patent Office or upon adjudication in court, under the statute, when novelty, utility, and unobviousness as defined in section 103 are found to exist, there is *patentability* and *that is the end of the matter*. An examination for the presence or absence of "invention," or of precedents on that muddy issue, is not called for and is not proper. It is a work of supererogation. It illustrates, furthermore, a failure to grasp the meaning of the statutory provisions. There is no such prerequisite in the statutory law.

[23] "Commentary on the New Patent Act," by P. J. Federico, 1954, published in Vol. 1 of 35 U.S.C.A.

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When, as is the case with the "requirement for invention," the century's accumulation of judicial precedents range from A to Z and Congress, looking at the situation under the guiding light of Kettering's statement that *this is no yardstick and the greatest technical weakness of the patent system,* determines to make a yardstick and says the measure shall be "M", right in the middle of the alphabet, it behooves everyone concerned with administering that law to follow the measure "M" and to stop flitting about arbitrarily from A to Z, lighting upon that letter which seems most appealing.

But what do we have today? A host of lawyers, examiners and judges all doing their level best to follow the law as Congress wrote it? Anything but that! What we have today is a mish-mash, and that is a nice old English term, older than the 1624 Statute of Monopolies. Why do we have a mish-mash?

First, a century of thinking and writing about a phenomenon in one set of nomenclature is a hard thing to overcome. Also a lot of people go on administering the patent laws and practicing under them without bothering to read the revision of them, so they are not aware that there has been a change.

Second, by hindsight it is apparent that those most intimately concerned with the writing and expounding of the new patent act in 1952, themselves brought up in the "requirement for invention" tradition (and I speak as one of them) did a very poor job of informing the public what it was they had done. One reason for that was that, on the average, their own comprehension of what they had done was not too clear. Remember, they were all of the school that "invention" *could not* be defined and there they were, trying to put a provision on that very subject into the statute. In going as far as seemed to be possible in that direction, they knew they were not making a *definition* but rather a *statement of policy,* a *specific required approach* to a difficult problem, which approach they thought would stop some of the nonsense derogatory of the patent system that had been going on. In pursuit of that objective, the drafters and Congress did one thing, by way of a statement of policy to counteract a judicial trend, which has had a clear-cut effect. Following a phrase casually dropped by the Supreme Court in *Cuno* v. *Automatic,*[24] in 1941, that "the new device, however useful it may be, must reveal the flash of creative genius," some courts took off on a quest for such a flash and, not finding it, invalidated patents. The last sentence of section 103 stopped

[24] The Cuno Engineering Corp. v. The Automatic Devices Corp., 314 U.S. 84, 52 USPQ 272 (1941).

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this abruptly with the legislative command: "Patentability shall not be negatived by the manner in which the invention was made." But the judicial reaction to the first sentence,[25] in contrast, got to be all fouled up.

Third, the members of the bar have a lot to answer for in creating and perpetuating the mish-mash because it is they who, desiring to make use of some of the extreme cases antedating the patent act to invalidate patents in litigation, played down section 103 and early in its life persuaded a number of courts that it made no change whatever but was "mere codification." [25a] They are now paying more attention to section 103 as they learn that it can help them when they are on the other side, but they are learning slowly and my generation of lawyers, at least, is still talking, out of habit, in terms of "invention." Just listen to them!

Find me a trial lawyer for an infringer who will not urge on the court, as the existing test for "invention," the views expressed by the Justices of the Supreme Court in *A & P* v. *Supermarket*, in 1950,[26] two years before the effective date of section 103, and I will joyfully transfer my Kettering Award to him. He would deserve it more than I do. I have no clients. Herein lies a grave defect in the development of sound law through adversary proceedings.

Fourth, in the legislature the mish-mash has been described in detail, up to 1957 (the first 5 years of the act) in Senate Committee Study No. 7. What is its title? "Efforts to Establish a Statutory Standard of Invention." [27] The Senate Patent Subcommittee is still striving to bring about a higher degree of uniformity in the courts, in the various groups of the Patent Office, and between the two

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[25] §103. *Conditions for patentability; non-obvious subject matter*

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

[25a] A little reflection should show that when judicial precedents constituting the "law" range from the very liberal to the most strict, it is a patent absurdity to speak of a statute taking a middle ground as a "codification" of existing law. See note 17a, *supra*.

[26] *Supra*, n, 15, 340 U.S. 147 . This was a case preeminently in the minds of the drafters of the 1952 Patent Act, having been decided during the writing of the first drafts. See note 17a.

[27] Study of the Subcommittee on Patents, Trademarks and Copyrights of the Committee on the Judiciary, U. S. Senate, 85th Cong., 1st Sess., pursuant to S. Res. 95, Study No. 7 (1958).

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organizations, but in what terms does it do its own thinking? The subcommittee's annual Report (No. 107), April 3, 1963, is concerned about the "Patent Office 'standard of invention'" and refers to the development by that office of a "policy statement pertaining to standards of invention." The report for the next year (No. 1018), May 1, 1964, again refers to the need to eliminate differences within the Patent Office and between it and the courts "concerning the standard of invention." Meanwhile, apparently without the committee's knowledge, the Patent Office Academy has been teaching that there is no "standard of invention," that "invention" is meaningless, and that the prerequisite is as stated in section 103. Might it not do some good and help to achieve the uniformity the subcommittee so much desires if its own members, and staff, could convince themselves, in spite of what uninformed judges have said, that the 1952 Patent Act was intended by their fellow legislators to *replace* the "standard of invention," which never was a standard, with a requirement of unobviousness to a particular kind of person at a particular time?

Amid the confusion, there are some encouraging signs in the courts. During the first few years after the 1952 act, many courts took the position that Congress really had done *nothing* in enacting section 103 and went about their old business of looking for "invention." Then in 1955 came Judge Learned Hand's *Lyon* v. *Bausch & Lomb* [28] opinion and in 1960 his *Reiner* v. *I. Leon* [29] opinion, both of which realistically appraised and appreciated what section 103 had done, namely, to restore the law to what it had been 20 or 30 years earlier and, as he said, "to change the slow but steady drift of judicial decision that had been hostile to patents * * *." In the former opinion he remarked that "'invention' became perhaps the most baffling concept in the whole catalogue of judicial efforts to provide postulates for indefinitely varying occasions." In the latter he said "It is not for us [the judiciary] to decide what 'discoveries' shall 'promote the progress of science and the useful arts' sufficiently to grant any 'exclusive right' of [to?] inventors. Nor may we approach the interpretation of §103 * * * with a predetermined bias." While saying "The test laid down [in 103] is indeed misty enough," he was able, with the evidence provided, to follow it. Certiorari was denied in both of these cases. In both cases the patents were sustained. The Supreme Court could easily have upset him had it wanted to. In fact, Judge Hand remarked to me and others at that Senate hearing in 1955 [30] "Oh, they

[28] Lyon v. Bausch & Lomb Optical Co., 224 F. 2d 530, 106 *USPQ* 1 (2d Cir. 1955).
[29] Reiner et al. v. I. Leon Co., 285 F. 2d 501, 128 *USPQ* 25 (2d Cir. 1960).
[30] *Supra*, n. 12.

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must take it," referring to *Bausch & Lomb*. Later during the hearing he testified,[31] "whether we were right in construing it [§103] as meaning that the old rules were to apply, remains to be seen. I hope the case will go up." From the viewpoint of the writers of the law, he was very right!

Last April (1964) the Fourth Circuit Court of Appeals in *Marvel v. Bell*,[32] which in 1954 said 103 merely codified the law, came to the conclusion, after reading a number of cases which "have undertaken to comprehensively set forth the standard of invention to be used as a test," that

"When the mass of verbiage has been distilled, however, we have little more to guide us than the test which is incorporated in section 103 * * *," and went in search of the "objective criteria of [un]obviousness." Perhaps, next time, that court will take the final step and *start* with the statute, ignoring the "mass of verbiage" it replaces. It seems a logical place to start, especially since it was intended to displace some of those cases in which the verbiage appears.

Last May (1964) the Sixth Circuit Court of Appeals, in *Monroe Auto Equipment Co.* v. *Heckethorn Mfg. Co.*,[33] said, "It is virtually a practical impossibility to define adequately that abstraction which we call invention," [34] and then, in spite of that difficulty, said "we must have objective references and a place from which to start. For this we turn to the statute * * * §103." A very good place to start! But then the court came to a very unnecessary conclusion "that invention is synonymous with unobviousness. Thus to say that a device lacks invention and that it is obvious is to state the same legal proposition in two ways." [35] It concluded that while obviousness "does not begin

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[31] *Id.* p. 120.

[32] 330 F. 2d 164, 141 *USPQ* 269.

[33] 141 *USPQ* 553.

[34] The full quotation is (141 *USPQ* at 553):

It is virtually a practical impossibility to define adequately that abstraction which we call invention. Long ago the Supreme Court said: "The truth is the word cannot be defined in such a manner as to afford any substantial aid in determining whether a particular device involves an exercise of the inventive faculty or not. In a given case we may be able to say that there is invention of a very high order. In another we can see that there is lacking that impalpable something which distinguishes invention from simple mechanical skill." McClain v. Ortmayer, 141 U.S. 419, 427 [Nov. 2, 1891]. This court consistently has echoed this view. [Cases cited.]

[35] A case was cited for this proposition, In re Jacoby, Jr., 309 F. 2d 513, 135 *USPQ* 317, 50 *CCPA* 734, in which the opinion was written by the present author. The Patent Office Board of Appeals had said the claimed invention "must be unobvious and involve invention." In a footnote to a reluctant but needed quotation of this statement the writer said:

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to solve the problem," it "gives us a touchstone for the contextual meaning of invention." It also concluded that in a patent case decision is arrived at by three steps: a determination of what the prior art was, what the patentee has made, and whether it would have been obvious, viewing the prior art from the time just prior to when the patented device was made. That is just what section 103 says! It is beginning to take hold and the next step will be to realize, what should be so clear, that when the unobviousness question has been determined, there is nothing more to do and the question of "invention" can be forgotten.[35]

I cite these as straws in the wind. A study in the *Columbia Law*

To add to the statement that it must be unobvious, as required by 35 U.S.C. 103, the further statement that it must "involve invention" is merely to state the same legal proposition in two different ways. It would seem to suffice to state it once, and that, preferably, in the words of the statute.

It should be clear that this was intended to put the proposition, developed more forcefully in the present paper, as gently as possible and that it was *not* intended to suggest that "invention" and "unobviousness" as provided in section 103 are alternative *equivalents* for determining patentability, which they are not.

[35] Along with it can be forgotten the "complexities" of another issue wrestled with by the court in deciding whether "unobviousness" is a question of law or fact. Compare Armour & Co. v. Wilson & Co., 274 F. 2d 143, 124 *USPQ* 115 (7th Cir. 1960). The presence or absence of "invention" before 1953 was always, in my judgment, the determination of an issue of public policy—what inventions *should* be patented. As such it is a "question of law." This policy has *now* been legislatively expressed in section 103. In that section (note 25, *supra*) the following potential issues of fact appear: (1) What are the *differences* between "the invention" and "the prior art"? (2) What is disclosed by the prior art presumed to have been available to the inventor? (3) What was the level of ordinary skill in the art at the time the invention was made? (4) Other fact issues relating to *circumstances* indicative of the presence or absence of obviousness, traditionally taken into account in determining "invention," such as long-felt need, immediate copying, sudden displacement of existing practices or devices, difficulty of achievement, failure of others, etc. Once these *facts* have been assembled, there remains the ultimate statutory requirement of unobviousness, the third requirement for patentability, which becomes a matter of statutory *application* and as such must be a question of law. As the court concluded in the *Armour & Co.* case, *supra*, "The development of the factual content necessary to statutory construction is a question of fact." It may be *several* such questions, however. As the court did *not* conclude in *Armour & Co.*, after the fact issues are settled, the determination of unobviousness is necessarily a legal conclusion arising out of the facts, pursuant to the statute —a question of law.

The *Armour* case concluded (1960), in the separate opinion devoted to the fact or law question, that after the facts were settled, "We examine the *standard of invention* applied to these facts as a question of law." (My emphasis.) But under section 103 there is no "standard of invention." The directive of the statute is to determine whether the invention "would have been obvious" on the basis of the *differences*, the *ordinary* skill, and as of the *time* of invention. *These* are the factors, and these alone, by which courts are to determine the existence of the third requirement. Leastwise, that is what the statute provides.

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Review in 1963[37] concludes that "nothing indicates that the courts are moving toward a common interpretation of the statute." I am not so sure. I say give them time. They are stirring like live cocoons. We have only had this statute for a dozen years and the judges who have been there that long, as many of them have, are still indoctrinated with the old "standard of invention" terminology they learned from the old patent lawyers and the old textbooks. There will be new editions of all three in due course.

I might mention the Court of Customs and Patent Appeals which has been turning out a consistent stream of opinions, for at least the eight consecutive years of which I have personal knowledge, strictly applying the obviousness formula of section 103 to determine *patentability*, not the presence of invention, and slowly but surely warping the Patent Office into basing its actions on the statute. The results are beginning to show in the actions and board opinions we review. I believe we have invaded the Patent Office Academy. The Solicitor's office writes its briefs in the language of the statute.

Assistant Secretary of Commerce Hollomon made a speech in New York in March, 1964, in which he is reported to have said that he "believes that the courts and the Patent Office should both follow the same standard *of patentability*." This would be nice but is obviously impossible until one or the other of them decides to standardize. A good place to begin would be the Patent Office, a lot easier than in the courts. Dr. Hollomon further said "that a standard of *patentability* should be more definitely set forth." He is to be complimented on his terminology, in not talking about a "standard of invention," but I think we should experiment with *using* the section 103 standard before we try to create another one. I find it very workable. It was a harder job to get it than he may imagine and in twelve years no better one has been proposed. The "criteria which may be worked out," referred to in the Revision Note to section 103, have never materialized. I doubt they ever will.

I have had two practical suggestions in the back of my mind for some time. One is to have sort of wallpaper border printed up to run around all the patent examiner's rooms on which the words NEW USEFUL UNOBVIOUS PATENTABLE are repeated endlessly. This could be designed into the new Patent Office building. Most inscriptions on the present Patent Office are not very useful. They might put on the

[37] "The Standard of Patentability—Judicial Interpretation of Section 103 of the Patent Act," 63 *Col. L. Rev.* 306-325 (Feb. 1963).

Constitutional clause so people could see it contains no *standard* for determining patentability.

The other suggestion—and this one is more serious—is based on the discovery that lecture courses are given for new and other Federal judges from time to time on how to be a judge, printed in books and given to the judges, compliments of the West Publishing Company. This Institute or some other disinterested party or organization should prepare a lecture on the basic elements of patent law in up-to-date terminology as used in Title 35 U.S.C. and see to it that the Federal judges get it. Even a glossary would help, in which it would appear that the "requirement for invention" became obsolete in 1953 by an act of Congress, along with many prior court opinions discussing it, being replaced by unobviousness as defined in 103 as the THIRD REQUIREMENT FOR PATENTABILITY. By limiting the lecture to the terms of the statute and their clear meanings I do not see how the bar could object and many judges would be grateful.

I was recently discussing this subject with a young patent lawyer, urging that we should all stop talking about the "standard of invention." She said, "What difference does it make?" That is a fair question which has to be answered, and with my present answers I will end:

The differences it will make—the reasons why we *must* learn to make this change—are these, among others:

–Until we stop talking about a "requirement for invention," it will never be clear that THE THIRD REQUIREMENT is that stated in section 103 *and no other*; that when 103 has been complied with, there is no further and different requirement called "invention"; that compliance with 103 is the policy judgment of Congress on how to bring the invention within the Constitutional purpose.

–Because looking for the presence of "invention" in addition to compliance with 103 defeats the legislative purpose.

–Because talking about both unobviousness and "invention" as different things leads to weird and confused thinking.

–Because testing patentability by the presence of "invention" gives judges and the Patent Office too much freedom to decide patentability of new and useful inventions on the basis of a personal view as to what *should* be patentable, instead of accepting the view of the legislature on that question of national policy.

–Because it will get all those concerned with the administration of the patent system—Patent Office, Courts, and the bar—speaking the same language, a sine qua non to the communication of intelligence.

–Because you cannot use "invention" as both an abstract noun and

a concrete noun in the same statute or opinion without confusion. The invention is the thing that has been produced by the "inventor." There will be muddy thought as long as one has to say: this invention (in the concrete sense) is unpatentable because it is not an invention (in the abstract sense).

—Because it will do more than anything else I can think of to bring about that long-sought-for greater uniformity of opinion on patentability.

—Because it makes the prerequisites to patentability intelligible.

As I hope I have been.

To quote Learned Hand—that well-named judge—once more, maybe I am only "shovelling smoke." Time alone will tell.

(Applause)

Editorial Note

AFTER BLACK ROCK: NEW TESTS OF PATENTABILITY—THE OLD TESTS OF INVENTION

Introduction

In *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*[1] the Supreme Court revived the illusory "invention" standard as a requisite of patent validity. In light of its apparent rejection by Congress and subsequent abandonment by the Court, the reappearance of this standard in *Black Rock* raises questions of vital concern to proponents of a functional patent system. The ample history of its application indicates that the "invention" requirement provided little guidance in determining patentability. Aptly termed "the plaything of the judges,"[2] it was never clearly defined nor consistently employed.[3]

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1. 396 U.S. 57, 163 U.S.P.Q. 673 (1969).
2. Judge Rich of the Court of Patent Appeals has stated:
   > In the final analysis, all it amounted to was that if the court thought the invention, though new and useful, was not patentable, then it did not involve "invention" and vice versa. The requirement for "invention" was the plaything of the judges who, as they became initiated into its mysteries, delighted to devise and expound their own ideas of what it meant; some very lovely prose resulting.

   Rich, *Principles of Patentability*, 28 GEO. WASH. L. REV. 393, 404 (1960).
3. Speaking of "invention," the Supreme Court has said:
   > The truth is the word cannot be defined in such manner as to afford any substantial aid in determining whether a particular device involves an exercise of the inventive faculty or not. In a given case we may be able to say that there is present invention of a very high order. In another we can see that there is lacking that impalpable something which distinguishes invention from simple mechanical skill. Courts, adopting fixed principles as a guide, have by a process of ex-

The presence or absence of "invention," ostensibly a guide to measure the patentee's claim, served rather as a vehicle for rationalizing a conclusion derived from judicial consideration of a variety of factors—factors as numerous as the courts which examined them.

The inconsistency and uncertainty which attended the courts variegated approach prompted Congress to prescribe a statutory solution.[4] The Patent Act of 1952 established a precise standard expressed in terms of nonobviousness. The nonobviousness test, embodied in section 103 of the Act, compels a comparison between the subject matter of the patent and the previous state of the art to determine whether the patentee's contribution to the useful arts would have been obvious at the time of its formulation. The standard of reference for that determination is a person possessing "ordinary skill" in the pertinent art. Congress recognized the ambiguity of the term "invention" and specifically chose not to include it in section 103.[5]

The *Black Rock* decision represents a departure from the Court's adoption of the statutory requirement of nonobviousness as a sufficient gauge of patentability. Mr. Justice Douglas, writing for the full Court, clothed his opinion in the old language of "invention," thereby countenancing a more rigorous standard of patentability than that required by section 103 alone.

This note will explore the ramifications of the latest Supreme Court pronouncement as it affects the current test of nonobviousness. It is suggested that section 103 provides a reasonable standard which may be applied by the courts with the uniformity necessary to lend predictability to the patent system. To encumber the standard of nonobviousness with the vagueries of "invention," as *Black Rock* suggests, will produce confusion for the courts and uncertainty for those concerned with patent protection.

Before the Patent Act of 1952—The Requirement of Invention

The validity of a patent depends upon the presence of several conditions. "Novelty"[6] and "utility"[7] have been established as prerequisites of patentability since the Patent Act of 1793.[8] While these requirements originated with specific statutory provisions, the element of "invention" was judicially evolved. Despite congressional

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clusion determined that certain variations in old devices do or do not involve invention; but whether the variation relied upon in a particular case is anything more than ordinary mechanical skill is a question which cannot be answered by applying the test of any general definition.

McClain v. Ortmayer, 141 U.S. 419, 427 (1891).

4. The Patent Act of 1952, 35 U.S.C. § 103 (1964); *see* text accompanying note 90, *infra*.
5. *See* text accompanying notes 94-105, *infra*.
6. 35 U.S.C. § 102 (1964).
7. *Id.* § 101.
8. Patent Act of 1793, ch. 11, 1 Stat. 318.

silence, courts pointed to the enabling provision of the Constitution as the source of this third requirement of patentability. Article I, section eight authorizes Congress to issue patents in order to "promote the progress of science and the useful arts."[9] Examination of that expressed purpose of patent protection, coupled with use of the terms "inventors" to describe the patentees and "discoveries" to denote those creations which may be considered deserving of such protection, convinced the judiciary that a contribution must be characterized by something more than mere "novelty" and "utility" in order to be worthy of the exclusionary rights embodied in a patent.[10] That additional characteristic was denominated "invention."

The Supreme Court's initial verbalization of the standard of "invention" came in *Hotchkiss v. Greenwood*.[11] There, the patentee had claimed a method for facilitating the fastening of a door knob to its shank by making the knob out of clay. Affirming the judgment below, the Court stated that the door knob was unpatentable, "unless more ingenuity and skill in applying the old method of fastening the shank and the knob were required in the application of it to the clay or porcelain knob than were possessed by an ordinary mechanic acquainted with the business."[12] The *Hotchkiss* test fixed the skill level of the ordinary mechanic in the related business as the objective standard against which the presence of "invention" would be measured. In *Atlantic Works v. Brady*,[13] the Court reaffirmed its position by declaring that the patent laws were not meant ". . . to grant a monopoly for every trifling device, every shadow of a shade of an idea, which would naturally and spontaneously occur to any skilled mechanic or operator in the ordinary progress of manufactures."[14] A device would be denied patent protection if its formulation would have been apparent to a skilled

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9. U.S. CONST. art. I, § 8 states that: "The Congress shall have power to promote the progress of science and useful arts, by securing for limited Times to . . . Inventors the exclusive right to their . . . Discoveries. . . ."
10. Thompson v. Boisselier, 114 U.S. 1 (1884); *see* Gardner v. Herz, 118 U.S. 180 (1886). *But see* Rich, *Patentability*, *supra* note 2, at 405: "The words 'Inventors' and 'Discoveries' no more dictate that an invention must be better than does the promotion of progress clause. The Constitution, therefore, contains no such requirement." In *Thompson* the Supreme Court extended this argument to find statutory justification for the "invention" requirement by referring to the language of the Patent Act of 1836, ch. 357, § 6, 5 Stat. 119, which required that the patentee be an individual who had "discovered or invented a new and useful art, machine, manufacture or composition of matter." The Patent Act of 1870, ch. 230, § 24, 16 Stat. 201, identified the patentee as the one who "invented or discovered." Although neither of the statutes contained any explicit mention of "invention," the Court considered the requirement implicit in the Congressional language. Thompson v. Boisselier, *supra* at 13.
11. 52 U.S. (11 How.) 248 (1850).
12. *Id.* at 267.
13. 107 U.S. 192 (1882).
14. *Id.* at 200.

mechanic in the ordinary performance of his work.[15] It was in light of the *Atlantic Works* opinion that the Court reiterated its conclusion—first expressed in *Hotchkiss*—that "invention" was a necessary prerequisite of patentability.[16] The Court's expression of the test of "invention" emerging from *Hotchkiss* and *Atlantic Works* resulted in an exclusionary rule whereby a patent would be denied any device whose development would have been obvious to a mechanic skilled in the pertinent art.

Nineteenth century courts were generally responsive to the guidelines set out in *Hotchkiss*. Technology, still in its infancy in most fields, was usually within the comprehension of the lay judge. He was able to examine the patentee's claim from the posture of one skilled in the relatively uncomplicated art of the times and thereby evaluate the validity of a patent within the framework of the *Hotchkiss* test.[17]

In *Vinton v. Hamilton*,[18] the patentee claimed a cupola-furnace and a cinder-notch in combinaton, both elements being old and the cinder-notch being used with a blast furnace. The Court determined that the cinder-notch performed the same function when used with the cupola-furnace as it had when used with the blast furnace and thus its application to a different type furnace "would occur to any practical man, and that [therefore] there was nothing patentable in such application."[19] *Hall v. MacNeale*[20] concerned a patent claiming a solid conical bolt with a screw-thread on it. Since both the solid conical bolt and the use of a screw-thread on a cored conical bolt were known to the prior art, the Court concluded: "There was no invention in adding [the one element to the other]."[21]

The problem of defining "invention" became more critical in the twentieth century. The *Hotchkiss* standard for "invention," conceived in the context of an elementary technology, became difficult to apply to the complexities of an industrial age.[22] As a result, the courts began to elaborate upon the concept of "invention."[23] The

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15. The reader will note a similarity between this interpretation of the early *Atlantic Works* doctrine and the later nonobvious standard of section 103. Nonetheless the more common reference to a "trifling device" found in later decisions was restrictive and failed to address the question of nonobviousness. Although courts employed the "every trifling device" phrase to describe those devices which they felt lacked that "inventive" quality required for patentability, such application was no more than a statement of a legal conclusion. The opinion in *Atlantic Works* is more properly interpreted as a reaffirmation of the test set out in *Hotchkiss*. Although stated as a negative rule, it meant that a "trifling device" was that device which was obvious to the skilled mechanic or operator.

16. 114 U.S. 1 (1884).

17. *See generally* Dession, *The Trial of Economic and Technological Issues of Fact*, 58 YALE L.J. 1019, 1242 (1949) (pts. 1-2); Note, *Subtests of "Nonobviousness": A Nontechnical Approach to Patent Validity*, 112 U. PA. L. REV. 1169 (1964).

18. 104 U.S. 485 (1881).

19. *Id.* at 492.

20. 107 U.S. 90 (1882).

21. *Id.* at 96.

22. Note, *"Nonobviousness"*, *supra* note 17, at 1169-70.

23. *Hearings on H.R. 3760 Before Subcomm. No. 3 of the House Judiciary Comm.*, 82d Cong., 1st Sess. 58-70 (1951).

element of "invention" was variously described as patentable novelty,[24] the exercise of the inventive faculty[25] or the creative faculty,[26] and inventive skill or inventive effort.[27] This variety of definitions prompted Judge Learned Hand to conclude: "You could find nearly anything you like if you went to the opinions. It was a subject on which judges loved to be rhetorical."[28]

It was in the nature of their elaboration that courts differed markedly. The proliferation of tests and standards utilized to determine the presence or absence of "invention" produced inconsistent and unpredictable results. While some courts developed tests responsive to the objective standard expressed in *Hotchkiss*, others obscured the "invention" requirement in a morass of subjective criteria.

Subjective Tests

In determining the presence or absence of "invention," many courts looked to their own subjective notions of patentability.[29] The tests thus formulated were often expressed in a negative manner by characterizing the absence of "invention."[30] The postulate that substitution of materials did not constitute "invention" was illustrative of these rules.[31] In addition, courts determined that reversal of parts,[32] change of proportion,[33] change of location, size, degree and

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24. United Chromium, Inc. v. International Silver Co., 53 F.2d 390, 393, 11 U.S.P.Q. 108, 111 (D. Conn. 1931), *modified*, 60 F.2d 913, 15 U.S.P.Q. 51 (2d Cir.), *cert. denied*, 288 U.S. 600 (1932); *cf.* Howell Co. v. Royal Metal Mfg. Co., 93 F.2d 112, 36 U.S.P.Q. 45 (7th Cir. 1937).
25. Potts v. Creager, 155 U.S. 597, 608 (1895).
26. Turner v. Goldstein, 144 F.2d 338, 341, 69 U.S.P.Q. 53, 55 (10th Cir. 1946).
27. Ansonia Brass & Copper Co. v. Electrical Supply Co., 144 U.S. 11, 18 (1892); Smith v. Goodyear Dental Vulcanite Co., 93 U.S. 486, 497 (1876).
28. *Hearings on S. Res. 92 Before the Subcomm. on Patents, Trademarks and Copyrights of the Senate Comm. on the Judiciary*, 84th Cong., 1st Sess. 113 (1955). One witness who testified at the hearings held prior to passage of the Patent Act of 1952, described the mystery surrounding the word "invention" as an "enormous enveloping cocoon of metaphysical hocus-pocus." *Hearings on H.R. 3760, supra* note 23, at 58. Such comments reflect the confusing and conflicting principles which courts applied in rendering determinations of patent validity prior to the enactment of the Patent Act of 1952.
29. Although termed "subjective," the tests are better characterized as nonresponsive to the requirements of the *Hotchkiss* standard of "invention."
30. One comprehensive survey of rules of "invention" included a list of fourteen situations where "invention" was absent. Deller, *The Problem of Invention in the Law of Patents*, 28 J.P.O.S. 797, 802 (1946).
31. *See, e.g.*, Heath v. Frankel, 153 F.2d 369, 68 U.S.P.Q. 132 (9th Cir.), *cert. denied*, 328 U.S. 844 (1946); Evr-Klean Seat Pad Co. v. Firestone Tire and Rubber Co., 118 F.2d 600, 49 U.S.P.Q. 129 (8th Cir. 1941); Paine & Williams Co. v. Baldwin Rubber Co., 113 F.2d 840, 46 U.S.P.Q. 109 (6th Cir. 1940).
32. *See, e.g.*, Hamilton Beach Mfg. Co. v. P.A. Geier Co., 230 F. 430 (7th Cir. 1916).
33. Ronning Mach. Co. v. Caterpillar Tractor Co., 129 F.2d 70, 53 U.S.P.Q. 593 (7th Cir.), *cert. denied*, 317 U.S. 670 (1942); Murphy v. Coe, 99 F.2d 994, 39 U.S.P.Q. 94 (D.C. Cir. 1938).

form,[34] and aggregation of parts[35] were not "invention." Determinations based upon these and other subjective rules[36] failed to identify the skill level in the art, or reflect a comparison between the prior art and the subject matter of the particular patent—considerations essential to determining whether the *Hotchkiss* standard of "invention" had been met.

Paralleling the development of these subjective tests was the emergence of a generally restrictive judicial attitude toward patent validity.[37] Courts used the subjective tests as tools to formulate a stricter standard of patentability congruent with the desire to protect the public from patent misuse.[38] In an early First Circuit decision,[39] holding that insertion of a paper tube between the outer shell of a lamp socket and the current-carrying parts of the socket lacked "invention," the court concluded that: "Reasonable consideration of such rules rejects the idea of accepting every ingenious and beneficial mechanical device as involving invention or discovery within the meaning of the Constitution and the statutes."[40] In the court's view, considerations of public policy mandated a rigorous evaluation of a patent as a prerequisite to the determination of validity. The opinion, however, offered no indication of the characteristics necessary to comply with this test.

The Supreme Court gave its approval to this stricter standard of patentability in *Sinclair & Carroll Co. v. Interchemical Corp.*[41] Con-

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34. *See, e.g.*, Schick Service, Inc. v. Jones, 173 F.2d 969, 81 U.S.P.Q. 60 (9th Cir.), *cert. denied*, 338 U.S. 819 (1949); Sales Affiliates, Inc. v. Nat'l Mineral Co., 172 F.2d 608, 80 U.S.P.Q. 389 (7th Cir.), *cert. denied*, 337 U.S. 940 (1946); McCurrach v. Cheney Bros., 152 F.2d 365, 67 U.S.P.Q. 254 (2d Cir. 1945).

35. *See, e.g.*, Lincoln Eng'r Co. v. Stewart-Warner Corp., 303 U.S. 545, 37 U.S.P.Q. 1 (1938).

36. *See* Deller, *The Problem of Invention*, note 30 *supra*.

37. A series of cases which emerged from the Court of Appeals for the District of Columbia Circuit in the 1940's was illustrative of a stricter attitude toward the patentee. In Special Equip. Co. v. Coe, 144 F.2d 497, 62 U.S.P.Q. 12 (D.C. Cir. 1944), *rev'd*, 324 U.S. 370 (1945), the court held that public policy required an applicant to have some expectation of exploiting the patent. In Monsanto Chem. Co. v. Coe, 145 F.2d 18, 62 U.S.P.Q. 37 (D.C. Cir. 1944), the court looked to the degree of control the applicant had in the industry to determine if a patent should be awarded. The court evidently reasoned that granting a patent to an applicant with monopolistic control over the industry to which the patent applied would "impede science and the useful arts." *Id.* at 23, 62 U.S.P.Q. at 42. Finally in Potts v. Coe, 145 F.2d 27, 62 U.S.P.Q. 331 (D.C. Cir 1944), the result of a step-by-step experimentation was held not to be "invention." This negative rule was formulated to impose a stricter standard on the corporate research and development facility, the court explicitly holding that an invention emerging from such a facility must meet a higher standard of patentability than a device conceived by an individual inventor. *Id.* at 28, 62 U.S.P.Q. at 333. These and similar decisions were reached by courts disposed to eliminate misuse of patents by means of expedient findings of lack of "invention."

38. The inherent judicial fear of monopoly may play a significant role in patent litigation. Judge Hand said: "I think a great deal of the odium that has surrounded the subject is because patents are monopolies." *Hearings on S. Res. 92, supra* note 28, at 114. It has been suggested that the harsh judicial attitude of the late thirties and forties may have derived from the Depression and the spirit of the New Deal reform, *e.g.* trust-busting. Gregg, *Tracing the Concept of "Patentable Invention,"* 13 VILL. L. REV. 98 (1967).

39. Marshall v. Wirt, 232 F. 606 (1st Cir. 1916).

40. *Id.* at 608.

41. 325 U.S. 327, 65 U.S.P.Q. 297 (1945).

cerned with developing a patent system which would serve society rather than aid the individual patentee, the Court chose to pursue this goal through its interpretation of the "invention" requirement.

> The primary purpose of our patent system is not reward of the individual but the advancement of the arts and sciences. Its inducement is directed to disclosure of advances in knowledge which will be beneficial to society; it is not a certificate of merit, but an incentive to disclosure.[42]

But again, there was no explication of the standards a patentee would have to achieve to obtain a patent which the courts would consider valid. This harsh attitude, which persisted throughout the thirties and forties,[43] was accurately summarized in Justice Jackson's objection to the "strong passion in this Court for striking them [patents] down so that the only patent that is valid is one which this Court has not been able to get its hands on."[44]

Objective Tests

While many courts chose the subjective approach, others sought respite from the confusion by formulating tests more responsive to the *Hotchkiss* standard. Recognizing the difficulties attendant judicial treatment of complex technological concepts,[45] they employed non-technical criteria[46] to provide evidence of the presence or absence of "invention."

> Among these will figure the length of time the art, though needing the invention, went without it: the number of those who sought to meet the need, and the period over which their efforts were spread: how many, if any, came upon it about the same time, whether before or after: and—perhaps most important of all—the extent to which it superseded what had gone before.[47]

Evaluation of the record, in light of these criteria, enabled the court in each case to render a more objective determination of patentability:[48] "We have repeatedly declared that in our judgment this

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42. *Id.* at 330-31, 65 U.S.P.Q. at 299.
43. *See* Cuno Eng'r Corp. v. Automatic Devices Corp., 314 U.S. 84, 51 U.S.P.Q. 272 (1941); note 86 *infra*.
44. Jungerson v. Ostly & Barton Co., 335 U.S. 560, 572, 80 U.S.P.Q. 32, 36 (1949) (dissenting opinion).
45. *See, e.g.*, Safety Car Heating & Lighting Co. v. General Elec. Co., 155 F.2d 937, 939, 69 U.S.P.Q. 401, 402-03 (2d Cir. 1946).
46. *See* Note, *"Nonobviousness,"* note 17 *supra*.
47. Safety Car Heating & Lighting Co. v. General Elec. Co., 155 F.2d 937, 939, 69 U.S.P.Q. 401, 403 (2d Cir. 1946).
48. *See, e.g.*, Kirsh Mfg. Co. v. Gould-Mersereau Co., 6 F.2d 793 (2d Cir. 1925); Van Heusen Prods., Inc. v. Earl & Wilson, 300 F. 922 (S.D.N.Y. 1924):
> The prospect of getting objective tests for invention is tempting, but it is a mirage. How is it possible to say *a priori* what combination of elements needs an original twist of the mind, and what is within the compass of the ordinary clod? Is it not clear that the

approach is more reliable than a priori conclusions drawn from vaporous, and almost inevitably self-dependent, general propositions."[49] Viewing the *Hotchkiss* standard as requiring comparison between the device and the prior art, these courts looked to the circumstances preceding, attending and succeeding its appearance to provide indirect evidence of nonobviousness:

> Courts, made up of laymen as they must be, are likely either to underrate, or to overrate, the difficulties in making new and profitable discoveries in fields with which they cannot be familiar, and, so far as it is available, they had best appraise the originality involved by the circumstances which preceded, attended and succeeded the appearance of the invention.[50]

Among the criteria considered was long felt need in the industry:[51]

> Long recognition of an existing problem in any art, and the advantages to accrue to an industry from its solution, coupled with repeated failures to find solution, has ever been considered as highly persuasive of invention when success is finally attained.[52]

Similarly, a history of prior efforts and failures by those in the industry was considered significant in determining the presence of "invention."[53]

Two additional criteria were recognized by the Supreme Court in *Goodyear Co. v. Ray-O-Vac Co.*[54] In considering whether encasing a battery in a leakproof metallic shell constituted "invention," Justice Roberts noted that over a period of half a century the use of flash light batteries had increased greatly and that during that time the manufacturers, knowing the defects in the batteries, had not devised a remedy. The Court felt the long delay in taking that step and the commercial success which greeted the innovation were entitled to weight in the determination of patentability.[55]

General public adoption, as evidenced by commercial success, attained wide acceptance as an indication of the presence of "inven-

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quality of a man's inventiveness must be tested by reconstituting the situation as it was in the light of the preceding history of the art?

Id. at 929.

49. Safety Car Heating & Lighting Co. v. General Elec. Co., 155 F.2d 937, 939, 69 U.S.P.Q. 401, 403.

50. *Id.*

51. *See e.g.*, Goodyear Co. v. Ray-O-Vac Co., 321 U.S. 275, 60 U.S.P.Q. 386 (1944); *In re* Sukman, 351 F.2d 656, 147 U.S.P.Q. 280 (C.C.P.A. 1965); Schnell v. Allbright-Nell Co., 348 F.2d 444, 146 U.S.P.Q. 322 (7th Cir. 1965); Twentier's Research, Inc. v. Hollister, Inc., 319 F.2d 898, 138 U.S.P.Q. 473 (9th Cir. 1963); Honolulu Oil Corp. v. Shelby Poultry Co., 293 F.2d 127, 130 U.S.P.Q. 289 (4th Cir. 1961); Trabon Eng'r Corp. v. Dirkes, 136 F.2d 24, 58 U.S.P.Q. 97 (6th Cir. 1943); Seymour v. Ford Motor Co., 44 F.2d 306, 7 U.S.P.Q. 182 (6th Cir. 1930).

52. Cleveland Trust Co. v. Schriber-Schroth Co., 92 F.2d 330, 334, 35 U.S.P.Q. 475, 479 (6th Cir. 1937).

53. Trabon Eng'r Corp. v. Dirkes, 136 F.2d 24, 58 U.S.P.Q. 97 (6th Cir. 1943).

54. 321 U.S. 275, 60 U.S.P.Q. 386 (1944).

55. *Id.* at 279, 60 U.S.P.Q. at 388. The majority opinion should be read in contrast with Justice Black's dissent which conformed to the stricter standard of patentability required by the Court in other cases. To Justice Black the real discovery was "that liquids would not leak through leak-proof solids," and that discovery, he maintained, "predated the dawn of written history." *Id.* at 280, 60 U.S.P.Q. at 388.

tion."[56] As a measure of public acceptance, commercial success evidenced nonobviousness since it was achieved by satisfying a previously unfulfilled need.[57] Moreover, while general acceptance was accorded weight, the Sixth Circuit recognized, "that where success follows acceptance by experts rather than by those unskilled, it is of far greater tribute to the ingenuity of the inventor."[58]

Occasionally the courts considered the action of competitors as evidence of nonobviousness.[59] They found "invention" indicated by a competitor's continuing infringement in the face of litigation and unsuccessful attempts to avoid the patent by minor modifications.[60] Considered also was substantial duplication of a patentee's device or process by an alleged infringer who was unable to circumvent it.[61]

The action of an alleged infringer after termination of a license under the patent and the existence of licenses based on substantial consideration were each considered indicative of "invention." If the former licensee continued to make, use or sell after termination of the license, the case for patent validity was thereby strengthened.[62] Commercial acquiescence by competitors in the form of acceptance of licensing agreements was also considered evidence of invention.[63]

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56. Paramount Publix Corp. v. American Tri-Ergon Corp., 294 U.S. 464, 24 U.S.P.Q. 303 (1935); Smith v. Snow, 294 U.S. 1, 24 U.S.P.Q. 26 (1935); Tempco v. Apco, 275 U.S. 319 (1928); Eibel Process Co. v. Minnesota & Ontario Paper Co., 261 U.S. 45 (1923); Minerals Separation, Ltd. v. Hyde, 242 U.S. 261 (1916); Hollister v. Benedict Mfg. Co., 113 U.S. 59 (1885); Trabon Eng'r Corp. v. Dirkes, 136 F.2d 24, 58 U.S.P.Q. 97 (6th Cir. 1943); Cleveland Trust Co. v. Schriber-Schroth Co., 92 F.2d 330, 35 U.S.P.Q. 475 (6th Cir. 1937); National Battery Co. v. Richardson Co., 63 F.2d 289, 17 U.S.P.Q. 60 (6th Cir. 1933); Naivette v. Bishinger, 61 F.2d 433, 15 U.S.P.Q. 200 (6th Cir. 1932). A problem would arise, however, when there were alternative explanations for the commercial adoption, *e.g.*, a successful marketing campaign to promote the product. In such cases its weight as an indicator of "invention" would be greatly reduced.

57. In addition, in the typical situation commercial success was easy to measure by an analysis of increased sales and demand for the product or process patented.

58. Cleveland Trust Co. v. Schriber-Schroth Co., 92 F.2d 330, 335, 35 U.S.P.Q. 475, 480 (6th Cir. 1937).

59. *See* Williams Mfg. Co. v. United Show Mach. Corp., 121 F.2d 273, 50 U.S.P.Q. 264 (6th Cir. 1941); Consolidated Rubber Tire Co. v. Diamond Rubber Co., 162 F. 892 (2d Cir. 1908).

60. *See* Williams Mfg. Co. v. United Show Mach. Corp., 121 F.2d 273, 50 U.S.P.Q. 264 (6th Cir. 1941).

61. *See* Blake v. Robertson, 94 U.S. 728 (1876); Gen. Tire & Rubber Co. v. Fisk Rubber Corp., 104 F.2d 740, 41 U.S.P.Q. 346 (6th Cir. 1939); Gen. Elec. Co. v. Wagner Elec. Mfg. Co., 130 F. 772 (2d Cir. 1904).

62. *See* Stevens v. Schmid, Inc., 73 F.2d 54, 23 U.S.P.Q. 117 (2d Cir. 1934); Detroit Motor Appliance Co. v. Taylor, 66 F.2d 319, 18 U.S.P.Q. 226 (7th Cir. 1933); Adam v. Folger, 120 F. 260 (7th Cir. 1903).

63. Judge Hand described the "trade-off" which the licensee faces:

> [A]cquiescence has often been taken as evidence of invention upon preliminary injunction, but the force of the inference is variable. The reasoning is that if licensees consent to pay tribute, they must believe the disclosure to be patentable, and that this is evidence that it was beyond commonplace contrivance. But when a manufacturer takes a

These were some of the criteria adopted by those courts which sought objective guides for their evaluations of patentability. The relative weight given a particular factor varied with the facts of each case. But in each instance they provided evidence manageable by a lay judge, enabling him to arrive at a more objective determination of patent validity.

Patents for Mechanical Combinations—An Illustration

In later opinions, the Supreme Court assumed a general posture which evidenced a more negative and subjective attitude. The analysis which the Court applied in cases treating mechanical combinations illustrates the confusion attendant its vagrant approach. These cases dealt with devices claimed as combinations of mechanical elements. In some instances each of the elements was known in the prior art; in others, an element of the combination was itself new; but in all cases, patentability was claimed for the combination rather than any individual mechanical element. Couched in terms of the *Hotchkiss* standard, the patentee's assertion was that one skilled in the relevant art would not find it obvious to combine these elements to produce the claimed device.

In *Lincoln Engineering Co. v. Stewart-Warner Corp.*,[64] the patent in question dealt with an apparatus for lubricating bearings of the type used in automobiles. The means of lubrication known in the art consisted of a pressure pump for propelling the lubricant, a hose for conveying it, a fitting to join the lubricating apparatus to the bearing to be so treated and a coupling element to unite the fitting to the hose. The claimed combination differed from prior art in the coupling member, and the Court conceded the patentability of the coupler, at least *arguendo*.[65] Rather than claiming that element broadly, the patentee claimed it in combination with the other parts, i.e., pump, hose, and fitting. The Court declared the "patent . . . void as claiming more than the applicant invented."[66]

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license, it is the resultant of two opposed motives, its cost and the dangers of infringement; and the magnitude of neither factor can be ascertained without knowing that of the other.

Ruben Condenser Co. v. Copeland Refrigeration Corp., 85 F.2d 537, 541, 31 U.S.P.Q. 6, 10 (2d Cir. 1936). *See* Eibel Process Co. v. Minnesota & Ontario Paper Co., 261 U.S. 45 (1923).

64. 303 U.S. 545, 37 U.S.P.Q. 1 (1938).

65. *Id.* at 549, 37 U.S.P.Q. at 3.

66. *Id.* The rationale of the Court's opinion is not clear from the expressed objection, i.e., that patentee claimed *more* than he invented. By claiming a patentable element in combination with other elements, a patentee actually dilutes his rights since only a device which comprises *all* of the claimed elements will directly infringe. It is suggested that the Court was disposed to render a decision adverse to the patentee because it considered judgment against the particular defendant in *Lincoln* inequitable. The action was brought against a manufacturer of fittings on the ground that the fittings were unusable and intended to be used in connection with the other elements of the claimed invention. The accused fitting was an "old" element and it would appear that the Court was opposed to construing the patentee's protection to include unpatented and unpatentable commodities. *See* Note, *Vending an Old Combination: A Patent Misuse - Antitrust Problem*, 37 Geo. L.J. 1057, 1060 (1969) wherein the *Lincoln* doctrine is considered in the context

The test perceived as the appropriate gauge of patentability in combination cases was: where old elements are joined, the combination must perform some new function. In keeping with the prevailing attitude, the Court chose to enunciate its rule in terms of what did not constitute "invention": "The mere aggregation of a number of old parts or elements which, in the aggregation, perform or produce no new or different function or operation than theretofore performed or produced by them, is not patentable invention."[67] The patentee was not benefited by the presence of a patentable element within the combination. The entire combination had to satisfy the rule: "[T]he improvement of one part of an old combination gives no right to claim that improvement in combination with other old parts which perform no new function in the combination."[68] It is difficult to reconcile this position with the *Hotchkiss* guideline since one possessing the average skill of the calling would not be able to combine elements to create a device where one or more of those elements was unknown to him.

In a later case, the Court affirmed the combination rule stated in *Lincoln*. The subject matter in *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*[69] was a check-out stand, as used in a grocery store. The device combined a counter with a slidable three-sided open-bottom frame so that groceries could be deposited at one end and pulled over by the cashier when he was ready to tally the shopper's bill and package the purchased goods. Although each of the claimed elements was known, the district court held the patent valid.[70] The Court of Appeals, impressed with evidence of wide adoption of the stand, substantial commercial success, increased rate of consumer check-out, decreased costs for merchants and apparent fulfillment of a need in the industry, affirmed the judgment of the trial court.[71] The Supreme Court, however, reversed, on the strength of its finding that the elements performed no new functions when in combination. The three-sided frame, combined with

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of extension of a monopoly.

Rather than treating the issue as one of infringement, the Court dealt with validity and arrived at the desired result — dismissal of the action — by declaring the patent invalid. Not only was the holding unnecessary, but the reasoning was incongruous in that the Court relied heavily on a prior case, Rogers v. Alemite Corp., 298 U.S. 415, 29 U.S.P.Q. 311 (1935), which dealt with a strikingly similar fact situation by holding that the patent was not infringed rather than declaring it invalid. Indeed, the Court, in that case, expressly stated that the claims were valid. *Id.* at 420, 29 U.S.P.Q. at 313.

67. 303 U.S. at 549, 37 U.S.P.Q. at 3.
68. *Id.* at 549-50, 37 U.S.P.Q. at 3.
69. 340 U.S. 147, 87 U.S.P.Q. 303 (1950).
70. Bradley v. Great Atl. & Pac. Tea Co., 78 F. Supp. 388, 77 U.S.P.Q. 343 (E.D. Mich. 1948).
71. 179 F.2d 635, 84 U.S.P.Q. 209 (6th Cir. 1950).

the counter, functioned as it would with any other table, and the counter supported groceries as it would without the frame.

Although in *A & P* the combination consisted of only old elements and was therefore distinguishable from the device in *Lincoln*, the prior decision was regarded as having accurately distilled the law on combinations.[72] The Court simply rephrased its test: "The conjunction or concert of known elements must contribute something; only when the whole in some way exceeds the sum of its parts is the accumulation of old devices patentable."[73]

This rule is insensitive to the lack of obviousness in bringing the several old elements together. A test which looks solely to the operation of the elements *after* they are combined must necessarily be premised on the unsound assumption that it is always obvious to take known things and combine them. It is the very unification of the elements, where the prior art fails to suggest such an action, that represents the advancement;[74] and the test of patentability should be directed to this factor.

The Court disposed of the patentee's evidence of long-felt need and commercial success by declaring these matters irrelevant to the determination of "invention."[75] The rejection of this evidence as bearing upon the question of patentability can only be attributed to the wide subjective discretion available to a court which employs a standard as cryptic as "invention."

The *Lincoln-A & P* test and the concomitant rejection of evidence such as commercial success and long-felt need, aided disposition of cases in accordance with the mandate expressed in *A & P* —that courts "scrutinize combination patent claims with a care proportioned to the difficulty and improbability of finding invention in an assembly of old elements."[76] Though on the facts these rules would appear limited in their applicability to the combination of mechanical elements, there is no justification for making a legal distinction based on the nature of the invention. As Judge Hand observed: "Substantially all inventions are the combination of old elements . . . ."[77] Recognizing that "element" has a

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72. 340 U.S. at 151, 87 U.S.P.Q. at 305.

73. *Id.* at 152, 87 U.S.P.Q. at 305.

74. Safety Car Heating & Lighting Co. v. General Elec. Co., 155 F.2d 937, 69 U.S.P.Q. 401 (2d Cir. 1946): "Substantially all inventions are for the combination of old elements; what counts is the selection, out of all their possible permutations, of that new combination which will be serviceable." *Id.* at 939, 69 U.S.P.Q. at 402.

75. "The Court of Appeals and the respondent both lean heavily on evidence that this device filled a long-felt want and has enjoyed commercial success. But commercial success without invention will not make patentability." 340 U.S. at 153, 87 U.S.P.Q. at 306.

76. *Id.* at 152, 87 U.S.P.Q. at 306.

77. Safety Car Heating & Lighting Co. v. General Elec. Co., 155 F.2d 937, 939, 69 U.S.P.Q. 401, 402 (2d Cir. 1946). *See* Reiner v. I. Leon Co., 285 F.2d 501, 128 U.S.P.Q. 25 (2d Cir. 1960), *cert. denied*, 366 U.S. 929 (1961): "It is idle to say that combinations of old elements cannot be inventions; substantially every invention is for such a 'combination'; that is to say, it consists of former elements in a new assemblage." *Id.* at 503, 128 U.S.P.Q. at 27; Ruben Condenser Co. v. Copeland Refrigeration Corp., 85 F.2d 537,

broader definition than "a mechanical part," and that "combination" connotes any "relationship" between known entities,[78] one can see that a sequence of old or known steps, a reaction between known chemicals, or a product having a combination of known properties are combinations of old elements no less than a lubricating device or check-out counter. The rules and judicial attitude towards "invention," expressed in the mechanical combination cases, could consequently be applied to the whole spectrum of patent cases.

The Patent Act of 1952

Legislative Intent

While *A & P* was being considered by the Supreme Court, the patent bar was aiding Congress in the preparation of comprehensive patent legislation. Among the provisions contemplated was the addition of a third statutory prerequisite to patentability.[79] With the decision in *A & P*, the drafters became convinced that "invention" could not be considered an adequate standard.[80] Language was sought which would be capable of consistent and predictable application while providing a reasonable basis for determining patentability. The artificial rules established to delineate that which was *not* "invention" were rejected as was the "new function" test of *Lincoln* and *A & P*. From the host of available expressions and tests, nonobviousness to one of ordinary skill in the art was chosen as the standard.

In adopting this frame of reference, the drafters revealed a preference for the earliest definitions of the third prerequisite of patentability, especially that set forth in *Hotchkiss v. Greenwood*.[81] While most cases deviated from the original judicial norm, some courts had adhered to it. The opinions of Judge Hand, speaking for the Second Circuit Court of Appeals, reflected sensitivity to the so-called "objective" evidence as tending to show what would or would not be within the skill of the calling.[82] This approach had

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31 U.S.P.Q. 6 (2d Cir. 1936), *cert. denied*, 300 U.S. 665 (1937): "[I]t is always the combination which counts, and no patents, or almost none, are made from new elements." *Id.* at 541, 31 U.S.P.Q. at 10.

78. *See* Bailey, *A Proposal for: A Standard of Patentability; Consonant Statutory Changes: A Manual on Determination of Patentability*, 41 J.P.O.S. 192, 212-215 (1961).

79. The other requirements are utility, 35 U.S.C. § 101 (1964), and novelty, 35 U.S.C. § 102 (1964).

80. *See* Rich, *Congressional Intent—Or, Who Wrote the Patent Act of 1952* in PATENT PROCUREMENT AND EXPLOITATION 61, 70 (1963).

81. 52 U.S. (11 How.) 248 (1850).

82. *See* Safety Car Heating & Lighting Co. v. General Elec. Co., 115 F.2d 937, 69 U.S.P.Q. 401 (2d Cir. 1946); Ruben Condenser Co. v. Copeland Refrigeration Corp., 85 F.2d 537, 31 U.S.P.Q. 6 (2d Cir. 1936).

been adopted by other courts.[83] Despite increasing strictness on the part of the Supreme Court,[84] the Court of Customs and Patent Appeals continued to apply the test it deemed appropriate. *In re Shortell*[85] expressed that court's determination to "continue to hold that if a process or thing constitutes patentable subject matter, is new and useful, and the process performed or thing produced would not be obvious to one skilled in the art, invention should be presumed and a patent may properly issue therefrom."[86] Congress vindicated this approach by embodying the nonobviousness standard in the Patent Act of 1952. Section 103 of that Act provided:

> A patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.[87]

The congressional intent in enacting the statutory standard was to afford uniformity in the determination of patentability, and the application of that criterion was expected to have a "stabilizing effect."[88] The legislators viewed the test of nonobviousness as a reasonable basis for distinguishing those inventions worthy of patent protection and considered it capable of consistent and predictable interpretation.

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83. *See* text accompanying notes 45-63, *supra*.

84. *See* text accompanying notes 37-44, *supra*; Picard v. United Aircraft Corp., 128 F.2d 632, 53 U.S.P.Q. 563 (2d Cir. 1942):

> We cannot, moreover, ignore the fact that the Supreme Court, whose word is final, has for a decade or more shown an increasing disposition to raise the standard of originality necessary for a patent. In this we recognize "a pronounced new doctrinal trend" which it is our duty, cautiously to be sure, to follow, not to resist.

Id. at 636, 53 U.S.P.Q. at 567.

Observers subsequently acknowledged the harsher standards of the Supreme Court. Judge Hand, in a 1955 decision, referred to the requirements of the preceding thirty years as being higher than those established in *Hotchkiss*, with Cuno Corp. v. Automatic Devices Corp., 314 U.S. 84, 51 U.S.P.Q. 272 (1941) representing "probably . . . the furthest departure" therefrom. Lyon v. Bausch & Lomb Optical Co., 224 F.2d 530, 536, 106 U.S.P.Q. 1, 6 (2d Cir. 1955). Hand alluded to this in hearings before the Senate in 1955 when he stated that "[i]t was pretty well accepted, I think, that perhaps 20 or 30 years ago, the Supreme Court had adopted a very much stiffer rule about what was invention." *Hearing on S. Res. 92, supra* note 28, at 119.

Statistical data indicated that the circuits regarded the Supreme Court as taking a stricter view toward patents and followed the high court's lead. In the same 1955 Hearings, P.J. Federico presented a report which included the following data: "U.S. Circuit Court of Appeals decisions: Percent held invalid: 1925-29 (33.4%); 1930-34 (38.0%); 1935-39 (50.9%); 1940-44 (60.5%); 1945-49 (64.5%); 1950-54 (60.7%)." *Id.* at 182-83.

Later cases reflected a recognition of the increased strictness demanded by the Supreme Court. *See* R.M. Palmer Co. v. Luden's, Ind., 236 F.2d 496, 499, 111 U.S.P.Q. 1, 4 (3d Cir. 1956), *cert. denied*, 352 U.S. 824 (1956); Ellis, Inc. v. Denis, 224 F.2d 311, 312, 106 U.S.P.Q. 125, 126 (1st Cir. 1955); Trico Prods. Corp. v. Delman Corp., 180 F.2d 529, 533, 84 U.S.P.Q. 416, 420 (6th Cir. 1950); *cf.* Kwikset Locks, Inc. v. Hillgren, 210 F.2d 483, 100 U.S.P.Q. 289 (9th Cir. 1954).

85. 142 F.2d 292, 61 U.S.P.Q. 362 (C.C.P.A. 1944).

86. *Id.* at 296, 61 U.S.P.Q. at 367. The court further stated: "In our opinion it is not within the province of the courts to establish new standards by which invention is to be determined. . . . [That] would be judicial legislation and not judicial interpretation." *Id.*

87. 35 U.S.C. § 103 (1964).

88. S. REP. No. 1979, 82d Cong., 2d Sess. 6 (1952).

It has been argued that Congress intended section 103 merely to codify the law of "invention" espoused by the Supreme Court at the time of its passage.[89] The legislation itself, as well as the events surrounding its enactment, adequately refute this thesis. Section 103 cannot be considered a reaffirmation of the tests employed by the Supreme Court, since it was the application of these very tests, culminating in the decision in *A & P*, which convinced the drafters that the "invention" standard had to be discarded, thereby precipitating the remedial action embodied in that provision.[90] Furthermore, the Senate committee report referred to section 103 as one of the major "innovations"[91] in a statute generally designed "to revise and codify the laws relating to patents."[92]

To insure that nonobviousness would displace "invention" as the norm, the Act retained the term "invention," but assigned to it a meaning wholly inconsistent with the previous usage of the phrase. "Invention" was defined as the thing discovered or created[93] and sections 101-03 set forth the conditions for ascertaining whether a particular invention was patentable.[94] Thus, every issued patent was to be regarded as disclosing an invention, limiting judicial inquiry to determination of the patentability of that invention. Judge Rich, an author of the legislation[95] and a persistent critic of the application of the

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89. *See* notes 108-14 *infra* and accompanying text.
90. *See* Rich, *Congressional Intent*, *supra* note 80.
91. S. REP. No. 1979, *supra* note 88, at 4.
92. *Id.* at 1.
93. 35 U.S.C. § 100 (1964).
94. Section 101, which specified the categories of subject matter considered to be within the purview of patent protection, was entitled "Inventions Patentable." 35 U.S.C. § 101 (1964). That usage distinguished "invention" from a requirement of patentability.
95. Congressional comment on the Act was rather scant. *See* Note, *The Standard of Patentability—Judicial Interpretation of Section 103 of the Patent Act*, 63 COLUM. L. REV. 306 (1963); Note, *Section 103 of the Patent Act and the Standards of Invention: Comments on Lyon v. Bausch & Lomb Optical Company*, 44 GEO. L.J. 100 (1955); Note, *Patent Law—Test of Invention*, 1956 WISC. L. REV. 513. It affords less insight into the legislative intent than do the views of the actual drafters of the legislation. These were not Congressmen, but rather patent practitioners. *See* Rich, *Congressional Intent*, *supra* note 80, at 73. Of these, Messrs. Federico, Rich, and Harris were the most prominent and qualified to relate the purpose of the statute. Indeed, in an address to the Patent, Trademark and Copyright Section of the American Bar Association, Mr. Crumpacker, a former Congressman and member of Subcommittee No. 3 of the House Committee on the Judiciary when hearings were held on H.R. 3760 (which matured into the Patent Act of 1952), advised that:

> When the courts, in seeking to interpret the language of the Act, go through the ritual of seeking to ascertain the "intent of Congress" in adopting same, they would do well to look to the writing of these men—Federico, Rich, Harris, and the others—as they, far more than any member of the House or Senate, knew and understood what was intended by the language used.

Crumpacker, *The Patent Act of 1952—A Congressional Perspective*, in SUMMARY OF PROCEEDINGS, A.B.A.—SECTION ON PATENTS, TRADEMARKS AND COPYRIGHT LAW 141, 143 (1962).

"invention" standard to determinations of patentability, stated emphatically that section 103 was included in the bill "in order to get rid of the vague requirement of 'invention.'"[96] As he observed: "Nowhere in the entire act is there any reference to a *requirement* of 'invention' and the drafters did this deliberately in an effort to free the law and lawyers from bondage to that old and meaningless term . . ."[97]

In one sense, it is accurate to label section 103 a "codification" of prior case law. The law which the provision codified, however, was that first announced in *Hotchkiss v. Greenwood* and later applied by some courts despite deviation by the Supreme Court. To view section 103 as reinforcing the High Court's subjective standards of patentability is to ignore the record and disregard the very purpose of its enactment.

Further examination of legislative intent indicates that the "non-obviousness" standard was considered productive of a more favorable climate for patent validity.[98] Judicial rulings under the aegis of "invention" increasingly tended to be adverse to the patentee.[99] As P.J. Federico, another author of the Act, noted:

> While it is not believed that Congress intended any radical change in the level of invention or patentable novelty, nevertheless, it is believed that some modification was intended in the direction of moderating the extreme degrees of strictness exhibited by a number of judicial opinions over the past dozen or more years; that is, that some change of attitude more favorable to patents was hoped for.[100]

Federico supported this conclusion by reference to the language of section 103: "[A] variety of expressions used in decisions were available . . . but the language selected was of the more moderate variety."[101] Moreover, the House committee report revealed that section 103 was intended to "'minimize great departures which have appeared in some cases.'"[102] As Federico correctly observed: "[T]he departures of which complaint has been made in the recent past are all departures in the direction of greater strictness and hence these would be what the report indicates should be minimized."[103]

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96. Rich, *Congressional Intent*, *supra* note 80, at 70.
97. Rich, *Patentability*, *supra* note 2, at 405 (emphasis added). He further advised: "[T]he requirement of invention should be referred to, if at all, only with respect due to that which is dead." *Id.*
98. L. James Harris, another of the drafters, said:
> If a random sampling of the items included in the revision is taken, some rather convincing evidence can be adduced of Congressional intent to moderate the strict interpretation of the courts and to encourage the courts to take a more friendly attitude toward patents, a practice from which they had departed in certain cases.

Harris, *Some Aspects of the Underlying Legislative Intent of the Patent Act of 1952*, 23 GEO. WASH. L. REV. 658, 679 (1954). *See also* Chin, *The Statutory Standard of Invention: Section 103 of the 1952 Patent Act*, 3 PAT., T.M. & COPR. FOUND. J. 317 (1959).
99. *See* notes 37-44 & 84 *supra* and accompanying text.
100. Federico, *Commentary on the New Patent Act*, 35 U.S.C.A. 1, 22-23 (1954).
101. *Id.* at 23.
102. H.R. REP. No. 7794, 82d Cong., 2d Sess. 7 (1952).
103. Federico, *New Patent Act*, *supra* note 100, at 23.

Judicial Interpretation

An early interpretation of the new statutory provision was provided by the Second Circuit in *Lyon v. Bausch & Lomb Optical Co.*[104] There, the patent was directed to a method of coating a lens in a vacuum which included the steps of preheating the optical surface, vaporizing the material to be deposited on the surface, and maintaining the lens in a heated condition during the deposition. Nowhere in the art was there a teaching of the expedient of heating the surface *during* the deposition. The invention yielded a lens with an adherent non-reflecting coating, a product diligently, but unsuccessfully, pursued for at least ten years by those skilled in the art. When it appeared, the process replaced the prevailing practice and substantially preempted the field. After weighing the patentee's evidence of long-felt need and commercial success, Judge Hand concluded: "We do not see how any combination of evidence could more completely demonstrate that, simple as it was, the change had not been obvious . . . to a person having ordinary skill in the art'—§ 103."[105]

The court's evaluation of the third prerequisite of patentability in terms of nonobviousness evidenced its recognition of the change effected by section 103. Indeed, Judge Hand asserted that

> had the case come up for decision within twenty, or perhaps, twenty-five, years before the Act of 1952 . . . it is almost certain that the claims would have been held invalid. The Courts of Appeal have very generally found in the recent opinions of the Supreme Court a disposition to insist upon a stricter test of invention than it used to apply—indefinite it is true, but indubitably stricter than that defined in § 103.[106]

Hand viewed section 103 as a codification of the test set forth in *Hotchkiss v. Greenwood*, which, if applied in the future, would relax the standards imposed by the Supreme Court in the years immediately preceding the Act and revive a uniformity long absent from the case law. In affirming this statutory purpose, he declared that "a legislature, whose will the courts have undertaken to proliferate, must be free to reinstate the courts' initial interpretation, even though it may have been obscured by a series of later comments whose upshot is at best hazy."[107]

Although the *Lyon* opinion was in harmony with both the plain language of section 103 and the legislative intent, Judge Hand's approach was not uniformly adopted. A number of courts, seizing upon the "codification" language of the Senate committee report,[108]

104. 224 F.2d 530, 106 U.S.P.Q. 1 (2d Cir.), *cert. denied*, 350 U.S. 911 (1955).
105. *Id.* at 535, 106 U.S.P.Q. at 5.
106. *Id.*
107. *Id.* at 537, 106 U.S.P.Q. at 7.
108. *See* S. REP. No. 1979, *supra*, note 88, at 1.

concluded that section 103 neither introduced a new test of patentability nor compelled a more moderate judicial disposition in evaluating patent validity. Accordingly, the opinions of these courts relied upon pre-1952 case law, such as *Lincoln* and *A & P* to test for the presence or absence of "invention."[109] A survey of appellate cases, decided after passage of section 103,[110] revealed that the First, Fifth, Sixth, Eighth and Ninth Circuits were of the opinion that no change was intended,[111] whereas the Third, Fourth and District of Columbia Circuits generally followed the Second Circuit in recognizing a new and more relaxed standard.[112] In reviewing the judicial attitude toward the new act, one court correctly characterized the divergence of opinion as a function of "the preexisting views of [each] tribunal as to the standard upon which it has determined patentability."[113] Uniformity, a primary goal of the 1952 Act, was thus frustrated by the failure of some courts to regard section 103 as controlling. Diversity of opinion flourished much as it had prior to passage of the Act.[114]

It was in light of this split among the circuits that the Supreme Court, in 1966, offered its interpretation of section 103. Choosing as its vehicle a trilogy of cases—*Graham v. John Deere Co.*,[115] *Calmar*,

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109. *See* note 111 *infra*.

110. Note, *Standard of Patentability*, *supra* note 95, at 313-25.

111. *See* Selmix Dispensers, Inc. v. Multiplex Faucet Co., 277 F.2d 894, 125 U.S.P.Q. 378 (8th Cir. 1960); Caldwell v. Kirk Mfg. Co., 269 F.2d 806, 123 U.S.P.Q. 182 (8th Cir.), *cert. denied*, 361 U.S. 915 (1960); Wasserman v. Burgess & Blacher Co., 217 F.2d 402, 404, 103 U.S.P.Q. 368, 369 (1st Cir. 1954); Vincent v. Suni-Citrus Prods. Co., 215 F.2d 305, 315, 102 U.S.P.Q. 373, 381 (5th Cir. 1954) (dictum since effective date of § 103 subsequent to trial), *cert. denied*, 348 U.S. 862 (1955); Kwikset Locks, Inc. v. Hillgren, 210 F.2d 483, 100 U.S.P.Q. 289 (9th Cir.), *cert. denied*, 347 U.S. 989 (1954); General Motors Corp. v. Estate Stove Co., 203 F.2d 912, 918, 97 U.S.P.Q. 84, 93 (6th Cir.), *cert. denied*, 346 U.S. 822 (1953), *adopted in* Roberts v. General Motors Corp., 228 F.2d 94, 99, 107 U.S.P.Q. 338, 341 (6th Cir. 1955), *cert. denied*, 352 U.S. 824 (1956); *cf.* Jeddeloh Bros. Sweed Mills, Inc. v. Coe Mfg. Co., 375 F.2d 85, 151 U.S.P.Q. 679 (9th Cir. 1967); Monroe Auto Equip. Co. v. Heckethorn Mfg. Co., 332 F.2d 406, 141 U.S.P.Q. 549 (6th Cir.), *cert. denied*, 379 U.S. 888 (1964); Ellis, Inc. v. Denis, 224 F.2d 311, 106 U.S.P.Q. 125 (1st Cir. 1955); Arnold Pipe Rentals Co. v. Engineering Enterprises, 350 F.2d 885, 888, 146 U.S.P.Q. 415, 418 (5th Cir. 1965); Stabler v. Bright Leaf Indus., 261 F.2d 383, 119 U.S.P.Q. 362 (5th Cir. 1958), *cert. denied*, 359 U.S. 990 (1959).

112. *See* Brown v. Brock, 240 F.2d 723, 728, 112 U.S.P.Q. 199, 203 (4th Cir. 1957); *cf.* Marvel Specialty Co. v. Bell Hosiery Mills, Inc., 330 F.2d 164, 141 U.S.P.Q. 289 (4th Cir.), *cert. denied*, 379 U.S. 899 (1964); R.M. Palmer Co. v. Luden's, Inc., 236 F.2d 496, 111 U.S.P.Q. 1 (3rd Cir 1956); L-O-F Glass Fibers Co. v. Watson, 228 F.2d 40, 107 U.S.P.Q. 197 (D.C. Cir. 1955) (appears to attempt to use obviousness standard although regards case law on "invention" viable after the act). *But see* Interstate Rubber Prods. Corp. v. Radiator Specialty Co., 214 F.2d 546, 548, 102 U.S.P.Q. 224, 226 (4th Cir. 1954). The Seventh and Tenth Circuits' views were regarded as unclear. Note, *Standard of Patentability*, *supra* note 95, at 322-23. Despite the Tenth Circuit's attempted application of the statute, neither court appeared to have recognized that a change was brought about by its passage. *See* Mott Corp. v. Sunflower Indus., Inc., 314 F.2d 872, 137 U.S.P.Q. 288 (10th Cir. 1963); Blish, Mize & Silliman Hardware Co. v. Time Saver Tools, Inc., 236 F.2d 913, 111 U.S.P.Q. 6 (10th Cir. 1956), *cert. denied*, 352 U.S. 1004 (1957); Blaw-Knox Co. v. I.D. Lain Co., 230 F.2d 373, 376, 108 U.S.P.Q. 356, 358 (7th Cir. 1956); Helms Prods. v. Lake Shore Mfg. Co., 227 F.2d 677, 683, 107 U.S.P.Q. 313, 317 (7th Cir. 1955).

113. R.M. Palmer Co. v. Luden's, Inc., 236 F.2d 496, 499, 111 U.S.P.Q. 1, 4 (3rd Cir. 1956).

114. *See* Note, *Standard of Patentability*, *supra* note 95, at 323.

115. 383 U.S. 1, 148 U.S.P.Q. 459 (1966).

Inc. and Colgate-Palmolive Co. v. Cook Chem. Co.,[116] and *United States v. Adams*[117]—the Court attempted to respond to the issues over which the courts of appeal had divided. In so doing, the Court essentially affirmed the position taken by Judge Hand in the *Lyon* opinion. Section 103 was held to be the applicable standard: "[W]e conclude here that the inquiry which the Patent Office and the courts must make as to patentability must be beamed with greater intensity on the requirement of section 103 . . . ."[118] The Court then set about defining the appropriate test by which to measure compliance with that standard.

Each of the three cases turned on the issue of nonobviousness. In *Graham*[119] and *Cook*[120] the inventions were found to be obvious and the patents in question held invalid. A contrary conclusion was reached in *Adams*.[121] Though the results differed, each opinion was marked by a carefully reasoned analysis focusing upon the question of obviousness or nonobviousness to one skilled in the art. The appropriate pattern of examination was set forth in *Graham*:

> [T]he scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the perinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc. might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have relevancy.[122]

The Court considered this approach capable of fairly consistent application which would yield the predictability sought by section 103:[123] "We believe that strict observance of the requirements laid down here will result in that uniformity and definiteness which Congress called for in the 1952 Act."[124] Although the judge must ultimately reach a legal conclusion, he would be guided by consideration of factors reasonably determinable by factual proof, *e.g.* the prior art, the subject matter patented, the differences between them and the level of skill of those practicing the art. It is significant that whereas the language of section 103 lends itself to the test an-

116. *Id.*
117. 383 U.S. 39, 148 U.S.P.Q. 479 (1966). The three cases, *Graham*, *Cook* and *Adams*, are hereinafter collectively referred to as the *Trilogy*.
118. 383 U.S. at 19, 148 U.S.P.Q. at 467.
119. *Id.* at 25, 148 U.S.P.Q. at 470.
120. *Id.* at 37, 148 U.S.P.Q. at 474.
121. *Id.* at 51, 148 U.S.P.Q. at 483.
122. *Id.* at 17, 148 U.S.P.Q. at 467.
123. *See* notes 79-92 *supra*, and accompanying text.
124. 383 U.S. at 18, 148 U.S.P.Q. at 467.

nounced by the Court, the "requirement of 'invention'" suggests no particular method of determination. Indeed, the Court cited with approval its earlier observation that 'the word ['invention'] cannot be defined in such a manner as to afford any substantial aid in determining whether a particular device involves an exercise of the inventive faculty or not."[125]

The *Trilogy* was in further agreement with *Lyon* on the issue of the relevance of nontechnical evidence[126]—the so-called "secondary considerations."[127] Such factors are quite susceptible to factual determination, and where they reasonably evidence the level of skill in the pertinent art, or tend to demonstrate that the difference between the prior art and the claimed invention is greater than the level of skill in the art, they are to be given evidentiary weight.

The application of these principles can best be gleaned from the *Adams* case where the validity of the patent on a battery composed of magnesium and cuprous chloride electrodes was affirmed. The invention was truly revolutionary in that it was the first practical, operative constant-voltage battery which used plain water rather than the electroytes traditionally employed.[128] The invention, however, was extremely "close" to the prior art which suggested the equivalence of its electrode materials to those previously used. The Court was impressed with evidence of the battery's unexpected results, the previous failure of prior art teachings to yield operative devices and noted experts' initial expressions of disbelief in the success of such an invention.[129] Despite its apparent structural similarity to prior devices, consideration of *all* evidence led the Court to conclude that the invention was not obvious.[130]

The expressed relevance of the "secondary considerations" in the determination of nonobviousness and the impact of their application in *Adams* was in striking contrast to the Court's prior standards for the determination of "invention."[131] By stating that "[t]he emphasis on non-obviousness is one of inquiry. . . ."[132] the Court acknowledged

125. *Id.* at 11-12, 148 U.S.P.Q. at 464, *citing* McClain v. Ortmayer, 141 U.S. 419, 427 (1891).

126. This was the "objective" or nontechnical body of evidence employed by some courts both prior to and after the 1952 act as an aid in making the difficult technical decisions required for the resolution of patent contests. *See* notes 45-63 *supra*, and accompanying text; Note, *"Nonobviousness"*, note 17, *supra*.

127. 383 U.S. at 17, 148 U.S.P.Q. at 467. These evidentiary considerations are "secondary" in the sense that they occupy a different level in the hierarchy of legal and factual conclusions. Obviousness is the ultimate issue; the claimed invention, prior art, level of skill in the pertinent art, and difference between the prior art and claimed invention as compared to the level of skill in the art are all sub-issues preliminary to the determination of obviousness. To resolve the crucial sub-issues a court entertains factual evidence such as the claims, specification and file history of the patent, prior patents, publications and testimony of those skilled in the art *and* any other facts such as commercial success and long-felt need.

128. 383 U.S. at 43, 148 U.S.P.Q. at 480.

129. *Id.* at 51-52, 148 U.S.P.Q. at 483-84.

130. For commentary on the *Trilogy*, see Kayton, *This Year (1966)* in *Patent Law*, 35 GEO. WASH. L. REV. 720, 721-25 (1966).

131. *See* notes 29-44, 64-78 *supra*, and accompanying text.

132. 383 U.S. at 17, 148 U.S.P.Q. at 467.

that the pattern of analysis, which it had outlined in *Graham*, was the very essence of the nonobviousness test. The application of that pattern in the *Trilogy* reflected the change necessitated by the test defined by Congress in section 103.[133] The Court insisted, however, that the change was one of "inquiry, not quality"[134] and that section 103 was intended to codify judicial precedents rather than alter the level of patentability.[135] In short, its conclusion was that while section 103 provided a new test, it did not mandate a more moderate judicial attitude. That position seemed inconsistent with the legislative intent. The issue was mooted, however, by the Court's substantive interpretation of section 103 and utilization of its pattern of factual analysis. The very application of the *Trilogy* analysis would tend to moderate the pre-1952 level of patentability by effecting predictable results. It provided, as the Court suggested, "a more practical test of patentability"[136] productive of objective evaluation and increased liberality in the consideration of the patentee's evidence.

After The Trilogy

In general, the courts of appeal responded to the *Trilogy* analysis by directing attention to the requirements of section 103.[137] A First

133. *See* notes 79-103 *supra*, and accompanying text.
134. 383 U.S. at 17, 148 U.S.P.Q. at 467.
135. *Id.*, 148 U.S.P.Q. at 466. It is interesting to note that the Court also denied that it had taken an increasingly strict posture during those years preceding the act. 383 U.S. at 19, 148 U.S.P.Q. at 467. Such a belief would tend to prevent the Court's acceptance of statutory moderation of case law standards since prior judicial strictness was a fundamental premise of the relaxation theory. *See* Lyon v. Bausch & Lomb Optical Co., 224 F.2d 530, 536, 106 U.S.P.Q. 1, 6 (2d Cir.), *cert. denied*, 350 U.S. 911 (1955). However, there is evidence that observers viewed such decisions as *Lincoln*, *Cuno* and *A & P* as deviations from earlier opinions. *See* notes 98-103 *supra*, and accompanying text. More importantly, the circuit courts of appeal viewed those decisions by the high court as having raised the level of patentability. See notes 37, 38 & 84 *supra*.
136. 383 U.S. at 17, 148 U.S.P.Q. at 467.
137. *See* University of Ill. Foundation v. Winegard Co., 402 F.2d 125, 159 U.S.P.Q. 129 (8th Cir. 1968), *cert. denied*, 394 U.S. 917 (1969); Kaiser Ind. Corp. v. McLouth Steel Corp., 400 F.2d 36, 158 U.S.P.Q. 565 (6th Cir. 1968), *cert. denied*, 393 U.S. 1119 (1969); Commissioner v. Deutsche Goldund-Silber-Scheideanstalt, 397 F.2d 656, 157 U.S.P.Q. 549 (D.C. Cir. 1968); Colourpicture Publishers, Inc. v. Mike Roberts Prods., Inc., 394 F.2d 431, 157 U.S.P.Q. 659 (1st Cir. 1968), *cert. denied*, 393 U.S. 848 (1969); National Connector Corp. v. Malco Mfg. Co., 392 F.2d 766, 157 U.S.P.Q. 401 (8th Cir.), *cert. denied*, 393 U.S. 923 (1968); Preuss v. General Elec. Co., 392 F.2d 29, 157 U.S.P.Q. 177 (2d Cir. 1968), *cert. denied*, 393 U.S. 834 (1969); Greening Nursery Co. v. J & R Tool & Mfg. Co., 376 F.2d 738, 153 U.S.P.Q. 660 (8th Cir. 1967); Sisko v. Southern Resin & Fiberglass Corp., 373 F.2d 866, 153 U.S.P.Q. 7 (8th Cir.), *cert. denied*, 389 U.S. 824 (1967); Ling-Temco-Vought, Inc. v. Kollsman Instrument Corp., 372 F.2d 263, 152 U.S.P.Q. 446 (2d Cir. 1967); Skee-Trainer, Inc. v. Garelick Mfg. Co., 361 F.2d 895, 150 U.S.P.Q. 7 (8th Cir. 1966); Jones Knitting Corp. v. Morgan, 361 F.2d 451, 149 U.S.P.Q. 659 (3d Cir. 1966). Despite the fact that the courts looked to section 103 more closely and couched their analysis in terms of obviousness or nonobviousness to one of or-

Circuit opinion, reversing a summary judgment of invalidity, evidenced this new attitude: "[I]t is apparent that the [district] court's conclusory comments as to 'lack of invention' fall short of that 'strict observance' of Graham's emphasis on an inquiry 'beamed with greater intensity on the requirements of § 103.'"[138] Seeking conformity with the *Graham* statement of the nonobviousness test, the Fifth Circuit stated:

> It is desirable that the district courts make specific findings on the factual matters which the Supreme Court, in Graham v. John Deere Co. . . . held determined obviousness: the state of the prior art, the level of ordinary skill in the art, and the difference between the prior art and the claims of the patent at issue.[139]

Moreover, that court specifically approved the district court's utilization of the "secondary indicia of commercial success and industry recognition of satisfaction of unsolved needs, referred to in *John Deere*."[140]

The *Trilogy* appeared to have subdued the conflict which had previously existed among the courts of appeal. By stressing the nonobviousness language of section 103 and delineating the pattern of analysis to be utilized in testing for the presence of this third statutory prerequisite of patentability, the Supreme Court had effectively disposed of the old tests of "invention." It was against that background of increasing appreciation of the *Trilogy* guidelines that *Black Rock* came to the district court.

Anderson's-Black Rock, Inc. v. Pavement Salvage Co.

In The Lower Courts

The asphalt paving industry had long been plagued with the problem of a deficient joint produced when a fresh strip of pavement was laid

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dinary skill in the art, some cases reflected adherence to the notion that section 103 was little more than a restatement of case law using the phrase "nonobviousness" as a synonym of "invention." *See* B.F. Goodrich Co. v. Rubber Latex Prods., Inc., 400 F.2d 401, 405, 158 U.S.P.Q. 513, 516 (6th Cir. 1968); Higley v. Brenner, 387 F.2d 855, 858, 155 U.S.P.Q. 481, 484 (D.C. Cir. 1967) (claimed invention nonobvious); Ludwig Drum Co. v. Solar Musical Instrument Co., 376 F.2d 827, 830, 153 U.S.P.Q. 579, 580 (6th Cir. 1967); *cf.* Carson v. Bland, 398 F.2d 423, 158 U.S.P.Q. 529 (10th Cir. 1968); Schmidinger v. Walsh, 383 F.2d 455, 155 U.S.P.Q. 289 (3d Cir. 1967), *cert. denied*, 390 U.S. 946 (1968) (claimed invention found to be nonobvious); Borden Co. v. Clearfield Cheese Co., 369 F.2d 96, 152 U.S.P.Q. 369 (3d Cir. 1966) (summary judgment of invalidity reversed on the finding that the issue of obviousness had not been adequately treated).

In addition, there was a general reluctance to give significant weight to the so-called "secondary considerations" even where nonobviousness was the standard applied. *See* Kaiser Indus. Corp. v. McLouth Steel Corp., 400 F.2d 36, 158 U.S.P.Q. 565 (6th Cir. 1968), *cert. denied*, 393 U.S. 1119 (1969); National Connector Corp. v. Malco Mfg. Co., 392 F.2d 766, 157 U.S.P.Q. 401 (8th Cir.), *cert. denied*, 393 U.S. 923 (1968); Greening Nursery Co. v. J & R Tool & Mfg. Co., 376 F.2d 738, 153 U.S.P.Q. 660 (8th Cir. 1967).

138. Colourpicture Publishers, Inc. v. Mike Roberts Prods., Inc., 394 F.2d 431, 434, 157 U.S.P.Q. 659, 661 (1st Cir. 1968).

139. Hensley Equip. Co. v. Esco Corp., 383 F.2d 252, 258 n.10, 155 U.S.P.Q. 183, 187 n.10 (5th Cir. 1967).

140. *Id.* at 258, 155 U.S.P.Q. at 187.

next to another that was cold. Heating, and thereby softening, the side of the strip already in place was known to encourage a good bond between the fresh and the old strips. Means of heating the asphalt, however, were inadequate. The patent in *Pavement Salvage Co. v. Anderson's-Black Rock, Inc.*[141] was drawn to a paving apparatus which included a heater capable of emitting highly penetrative radiant energy. The prior art disclosed the use of radiant heat to facilitate the bonding of asphalt. The specific heater used by the patentee was a prior art radiant heater; it was neither new nor patentable.

Testing the combination of paver and heater against the standards set forth in *Lincoln* and *A & P*, the district court concluded that combined the elements functioned as they did in tandem and held the patent invalid.[142] The patentee's assertions of commercial success and long-felt need were deemed unavailing in the absence of "invention."[143]

Responding to the *Trilogy* guidelines the Fourth Circuit reversed the district court's decision.[144] Rather than speaking in terms of old elements and combinations thereof, and tests which reveal little as to the obviousness of uniting them, the court posed this issue: "[T]he question is whether, in light of the availability of more efficient radiant energy generators, the answer obviously lay in the theretofore unworkable and discarded art of heat treatment."[145] The error of the lower court lay in its assumption that the problem could be solved by heat treatment with the specific radiant energy source. Acknowledging earlier use of radiant heaters in asphalt bonding, the Fourth Circuit noted that those employed had been ineffective because of their inability to yield sufficient penetrative heat.[146] The majority reasoned:

> Had it been known that the result could be achieved by a generator and a paving machine handled separately but cooperatively, combining the two in one machine for the sake of convenience would have been an obvious step, but that was not known. Neville [the patentee] supplied the whole answer which had completely eluded the industry. His contribution cannot be judged without reference to its salient feature, disclosure of the fact that the solution lay in the use of a specified kind of infra-

141. 404 F.2d 450, 159 U.S.P.Q. 513 (4th Cir. 1968).
142. *Id.* at 455-56, 159 U.S.P.Q. at 517. The district court opinion was unpublished. The dissent to the appellate court opinion, however, adopted the lower court position and reproduced portions of the unpublished decision. *Id.* at 454-55, 159 U.S.P.Q. at 516-17.
143. *Id.* at 455, 159 U.S.P.Q. at 517.
144. 404 F.2d 450, 159 U.S.P.Q. 513 (4th Cir. 1968).
145. *Id.* at 452, 159 U.S.P.Q. at 514.
146. *Id.* at 451, 159 U.S.P.Q. at 514.

red generator in combination with the basic paving machine.[147]

The Court of Appeals was impressed with evidence of the need for the apparatus, the continuing efforts to satisfy that need, the incredulity of those skilled in the art when originally confronted with the invention and its substantial success once the industry was convinced that it worked as claimed. In contrast to the trial court, the majority considered that evidence relevant " 'indicia of obviousness or nonobviousness' " as recognized by *Graham*.[148] Thus, after applying the *Trilogy* analysis the court concluded that it would not have been obvious to one of ordinary skill in the art to select the particular claimed radiant heater as the source of heat in the asphalt paving machine.[149] As nonobviousness was the salient test, the invention was patentable.

In the Supreme Court

The Fourth Circuit opinion represented an able application of the test of nonobviousness. Its review would have been an excellent opportunity for the Supreme Court to reaffirm the standards of section 103 set forth in the *Trilogy*—particularly as they related to mechanical combinations—and to quell the vitality of the tests of "invention" stated in *Lincoln* and *A & P*. Indeed, certiorari was granted,[150] but the result was not a restatement of *Graham*. To the contrary, in an almost incredible reversal of position, the old tests of "invention" were elevated to the status of new tests of patentability, and the plain language of section 103, the legislative purpose and the Court's previous construction were nullified.

The Court, speaking through Justice Douglas, applied a test of patentability bearing little similarity to that outlined in the *Trilogy*. By limiting inquiry to determination of whether the elements functioned in combination in any manner different from the way they would function in tandem,[151] Justice Douglas joined in the district court's assumption that the use of the specific radiant heater in the process of paving asphalt was known,[152] thereby regarding patentability as pivoting on the distinction between elements combined on one chassis and those maintained apart.[153] Unless

147. *Id.* at 454, 159 U.S.P.Q. at 516.
148. *Id.* at 452, 159 U.S.P.Q. at 514.
149. *Id.* at 454, 159 U.S.P.Q. at 516.
150. 394 U.S. 916 (1969).
151. 396 U.S. at 60, 163 U.S.P.Q. at 674.
152. The Court said that "experts tendered by respondent testified that they had been doubtful that radiant heat would solve the problem of the cold joint. But radiant heat was old in the art." 396 U.S. at 59-60, 163 U.S.P.Q. at 674. The court of appeals had acknowledged that radiant heat was taught in the art, but on the basis of the evidence found that those skilled in the art had turned away from the heat treatment to pursue other means of solving the problem. The specific radiant heater claimed and not disclosed in the paving art was found to produce the solution, and therefore the court of appeals regarded as nonobvious the selection of *that* heater for use with the standard paving gear. The Supreme Court did not respond to this reasoning, but rather proceeded from the premise that the particular radiant energy generator was recognized as useful in the paving of asphalt.
153. *Id.* at 60, 163 U.S.P.Q. at 674.

the elements in some way affected one another so that the effect produced by the whole exceeded the sum of the individual effects of its component parts, there was no "invention."[154] This was the test of *Lincoln* and *A & P*[155] and was as inappropriate to determination of the obviousness of the combination in 1969 as it had been before the 1952 Act.

Graham, however, was not ignored in the Court's opinion. After concluding that the patent was invalid under the old test of "invention," the Court justified its holding by citing *Graham* as authority for the propositon that section 103 merely codified the prior case law.[156] Finally, the *Graham* test of nonobviousness was quoted, but never actually applied. Without additional explication, the Court summarily concluded that "to those skilled in the art the use of the old elements in combination was not an *invention* by the obvious-nonobvious standard."[157] It is apparent that the Court resolved the validity of the patent on the basis of "invention." This is a plain reversal of the *Trilogy* instruction to emphasize the nonobviousness test of section 103.

While the Fourth Circuit was persuaded by nontechnical evidence, the Supreme Court treated such "secondary considerations" as irrelevant. The Court resorted to *A & P* for the proposition that these matters "without invention will not make patentability."[158] This view also represents a complete reversal of the *Trilogy*, as the Court there indicated that such factors were to be considered in the course of rendering a decision on obviousness.

In the final analysis, though *Lincoln*, *A & P*, section 103 and *Graham* all appear in the same opinion, they cannot co-exist in the determination of patent validity. The vague usage of "invention" to define patentable subject matter is not the same as the pattern of

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154. *Id.* at 61, 163 U.S.P.Q. at 674.
155. *Id.* at 60-61, 163 U.S.P.Q. at 674.
156. *Id.* at 62, 163 U.S.P.Q. at 675.
157. *Id.* (emphasis added). The Court made reference to 35 U.S.C. § 101 (1964) in note 4, asserting that "[a]bsent here is the element 'new' . . . [since] the combination added nothing to the inherent characteristics or function of the radiant burner." Then, the Court *further* concluded that the invention was obvious. It appears that invalidity was grounded on a lack of novelty, 35 U.S.C. § 102 (1964), yet the record was clear that although the elements were known per se, their combination was not directly taught in the prior art. The inquiry should therefore have been conducted under section 103.
The Court intimated that § 101 was the appropriate provision for determination of the validity of combination patents, although §§ 102 and 103 prescribe the specific circumstances under which the invention lacks novelty or is obvious. In view of those sections, there is really no need to speak in terms of combinations of old elements; there is no basis for distinguishing them from other inventions nor for holding them to a higher standard of patentability. The standards expressed in § 103 are applicable to all inventions, whether the prior art is extensive and close or sparse and unrelated.
158. *Id.* at 61, 163 U.S.P.Q. at 674.

analysis inherent in the determination of obviousness or nonobviousness set forth in section 103 and clarified in the *Trilogy*.[159] The revitalization of pre-1952 standards with all their inadequacies can occur only at the sacrifice of the advantages which flow from the statute. The problems which confronted the patentee before the 1952 legislation—absence of predictability in the approach adopted by the courts, inability to rely on evidence which logically establishes the degree of advance in the art represented by his invention, substantial likelihood of a finding of invalidity—will surely plague him again. The *Black Rock* decision essentially turns the clock back to that era by adopting the law as it was prior to the enactment of section 103.

After Black Rock

The *Black Rock* opinion appears to have already had some impact on the courts, and predictable trends are discernible even now. *Black Rock* and the *Trilogy* are clearly at odds on the issue of the relevance of the "secondary considerations." In *Stevenson v. Diebold, Inc.*,[160] the Ninth Circuit concluded that plaintiff's conveying device was an obvious development in light of a similar, previously patented invention. Although both machines were attempts at accomplishing the same result, the plaintiff's invention succeeded where the other had failed. The claimed device enjoyed commercial success and, as the court observed, most of the earlier machines were converted into the type developed by the plaintiff. The court, however, relying upon *Black Rock* to support its disregard of plaintiff's "secondary" evidence of nonobviousness,[161] concluded that the plaintiff's device was simply a modification of the prior invention, made obvious by the prior teaching of a third party.

The *Black Rock* position cannot be confined to commercial success but will rather be assumed to apply to the spectrum of "nontechnical" evidence. Conversion of the machines in the *Stevenson* case is an example of such evidence.[162] In another Ninth Circuit case, *Bada Co. v. Montgomery Ward & Co.*,[163] the authority of *Black Rock* was invoked to justify the court's conclusion of obviousness in the face of conceded commercial success and solution of what had been a problem in the pertinent industry.[164] While some cases decided since *Black Rock* have regarded such evidence as relevant,[165] it is diffi-

159. *See* notes 115–36 *supra*, and accompanying text.
160. 422 F.2d 1223, 165 U.S.P.Q. 10 (9th Cir. 1970).
161. *Id.* at 1233, 165 U.S.P.Q. at 14.
162. *See* notes 45–63 *supra*, and accompanying text; Note, "*Nonobviousness*", note 17 *supra*.
163. 426 F.2d 8, 165 U.S.P.Q. 483 (9th Cir. 1970).
164. *Id.* at 10, 165 U.S.P.Q. at 484.
165. Cf. National Athletic Supply Corp. v. Tone-O-Matic Prods., 421 F.2d 407, 164 U.S.P.Q. 330 (8th Cir. 1970); Technograph Printed Circuits Ltd. v. United States; — F.2d —, 164 U.S.P.Q. 584 (Ct. Cl. 1970); Brown v. Myerberg, — F. Supp. —, 164 U.S.P.Q. 505 (S.D.N.Y. 1970); Nashua Corp. v. RCA Corp., 307 F. Supp. 182, 165 U.S.P.Q. 89 (D.N.H. 1969).

cult to reconcile that reasoning with the position of the Supreme Court as expressed in *Black Rock*. Most courts, it is submitted, will follow the lead of the High Court.

Erosion of the viability of these "secondary considerations," as proof of nonobviousness, can be expected to increase the likelihood that courts will grant summary judgments of invalidity. In *Palmer v. United States*,[166] the Court of Claims denied the government's motion for summary judgment holding that "plaintiffs are entitled to their day in court to make out what case they can for unobviousness."[167] The court's conclusion, however, was premised upon acceptance of commercial success and satisfaction of long-felt need as evidence of nonobviousness.[168] Similarly, in *Faraday, Inc. v. Audio Devices, Inc.*,[169] a district court concluded that under the rule announced in *Graham* such considerations were germane "even if they cannot 'breathe life' into a patent otherwise invalid."[170] Despite its failure to delineate the weight to be given these factors, the court indicated that the presence of such evidence would discourage it from granting summary judgment.[171] It is suggested, however, that if the position in *Black Rock* is taken to its logical extreme, courts will hold all such evidence irrelevant and grant summary judgment more readily.[172] This would appear to be the view adopted in *Pacific International Plastics v. Sterling Plastics Corp.*[173] There, the court, ignoring affidavits filed in support of the patentee's claim of commercial success, declared that consideration of such evidence "could not affect the result."[174]

Just as the holdings in *Lincoln* and *A & P* could not have been limited to patents claiming combinations of mechanical elements, it would be unsound to so confine *Black Rock*. Recent cases reflect a growing recognition of the sweeping significance of the combination concept. In *Bada Co. v. Montgomery Ward & Co.*,[175] the invention was a four-step method of balancing automobile tires. After citing the prior art which, in the court's opinion, disclosed the individual steps but not the claimed combination thereof, it charac-

166 — F. Supp. —, 155 U.S.P.Q. 524 (Ct. Cl. 1967), *aff'd*, 182 Ct. Cl. 896, 158 U.S.P.Q. 689 (1968).
167. *Id.* at —, 155 U.S.P.Q. at 528.
168. *Id.* at —, 155 U.S.P.Q. at 527.
169. — F. Supp. —, 165 U.S.P.Q. 634 (S.D.N.Y. 1970).
170. *Id.* at —, 165 U.S.P.Q. at 638.
171. "That there is evidence of commercial success or failure may at least require added caution on a motion for summary judgement." *Id.* at —, 165 U.S.P.Q. at 638. *See* Colourpicture Publishers, Inc. v. Mike Roberts Color Prods., Inc., 394 F.2d 431, 157 U.S.P.Q. 659 (1st Cir. 1968).
172. Of course, those courts which continue to give full weight to nontechnical considerations will surely follow the reasoning of *Palmer*.
173. 305 F. Supp. 1341, 164 U.S.P.Q. 35 (C.D. Cal. 1969).
174. *Id.* at 1344, 164 U.S.P.Q. at 38.
175. 436 F.2d 8, 165 U.S.P.Q. 463 (9th Cir. 1970).

terized the invention as "merely a combination of known prior art elements."[176] Similarly, in *Indiana General Corp. v. Krystinel Corp.*,[177] chemical combinations were equated with mechanical combinations,[178] and in *Decca Ltd. v. United States*,[179] the Court of Claims analogized combinations in the electrical field to those of the type considered in *Black Rock*.[180] Thus, the *Black Rock* doctrine has broad applicability, extending to virtually every patent suit.

Perhaps the most dire consequence of *Black Rock* is the judicial attitude it establishes toward questions of patent validity. The Ninth Circuit recognized the posture assumed by the Supreme Court when, in *George J. Meyer Manufacturing Co. v. San Marino Electronic Corp.*,[181] it affirmed the trial court's conclusion of invalidity for obviousness, stating: "The result reached . . . is in accord with the statutory requirement of nonobviousness and the 'strict observance' of the statute required by the recent decisions of the Supreme Court."[182] Only *Black Rock* was cited and the court implied that the decision there compelled a "strict" construction of section 103, "strict" meaning adverse to patentees. As used in *Graham*, "strict" observance of section 103 was the Court's direction to the Patent Office and the courts to discontinue their practice of rendering decisions on the basis of the harsher and less objective pre-1952 "invention" standard, and instead follow the statutory guidelines.[183] *Black Rock* has totally reversed that command and from *Meyer Manufacturing* it appears that at least one court of appeals reads the Supreme Court as taking a discordant view toward patent validity.[184] Other courts will be likely to adopt this attitude.

A recent district court case provides a good example of how a patentee can be faced with an apparent presumption of invalidity where the appellate courts have reflected a hostile judicial attitude toward patents. In *Woodstream Corp. v. Herter's Inc.*,[185] the inventions of the two patents in suit were animal traps. The court indicated that the traps were substantial improvements over previous traps, were significantly more humane and enjoyed considerable commercial success. Ultimately, the court found the inventions

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176. *Id.* at 10, 165 U.S.P.Q. at 484.
177. 421 F.2d 1023, 164 U.S.P.Q. 321 (2d Cir. 1970).
178. *Id.* at 1033, 164 U.S.P.Q. at 329.
179. 420 F.2d 1010, 164 U.S.P.Q. 348 (Ct. Cl. 1970).
180. *Id.* at 1024, 165 U.S.P.Q. 359.
181. 422 F.2d 1285, 165 U.S.P.Q. 23 (9th Cir. 1970).
182. *Id.* at 1289, 165 U.S.P.Q. at 27.
183. *See* Graham v. John Deere Co., 383 U.S. 1, 17, 148 U.S.P.Q. 459, 466 (1966); *see* notes 115-36 *supra*, and accompanying text.
184. *Meyer Manufacturing* is but one of a string of Ninth Circuit cases holding the patent in suit invalid. Others decided since the *Black Rock* opinion was handed down are: Bada Co. v. Montgomery Ward & Co., 426 F.2d 8, 165 U.S.P.Q. 483 (9th Cir. 1970); Stevenson v. Diebold, Inc., 422 F.2d 1228, 165 U.S.P.Q. 10 (9th Cir. 1970); Hamlow v. Scientific Glass Apparatus Corp., — F.2d —, 164 U.S.P.Q. 340 (9th Cir. 1970); Spring Crest Co. v. American Beauti Pleat, Inc., 420 F.2d 950, 164 U.S.P.Q. 281 (9th Cir. 1970); Carborundum Co. v. Wilbanks, Inc., 420 F.2d 43, 164 U.S.P.Q. 271 (9th Cir. 1969).
185. 312 F. Supp. 369, 165 U.S.P.Q. 609 (D. Minn. 1970).

obvious, noting the absence of a "'flash of creative genius.'"[186] Initially, however, the court observed that:

> The courtrooms within the province of the Eighth Circuit Court of Appeals do not afford a congenial forum to the holder of a United States patent. A reading of the decided cases clearly reflects this. . . . I can find no record of the Eighth Circuit Court of Appeals upholding the validity of a patent since Graham. It did so sparingly before Graham.[187]

It is submitted that this recognition of adversity toward patents by appellate courts and the concomitant likelihood of reversal in the event validity were upheld, prejudices those courts against the patentee. In view of the atmosphere created by the Supreme Court in *Black Rock*, it may not be long before all the courts will be paraphrasing the district court in *Woodstream* and acknowledging that "the courts of the United States do not afford a congenial forum to the holder of a United States patent."

Conclusion

While the response of a particular court may not be predicted with absolute certainty, it may be presumed that *Black Rock* will revive the divergence once prevalent among the circuits. The availability of a broad spectrum of language, ranging from the tests of *Lincoln* to the analysis of the *Trilogy*, places a patentee in the impossible position of attempting to estimate the strength of the case he must make to secure a patent. Further, the rigorous position taken in *Black Rock* seriously jeopardizes existing patents. This is precisely the situation which preceded the 1952 Act and prompted its enactment. Just as Congress was then the only body capable of affording relief, so it appears to be now. If Congress acts, however, it should make clear its policy with regard to the patent system and offer no opportunity for a further re-vitalization of the old tests of "invention." Recognizing that courts will seek means of relying on *Lincoln*, *A & P* and now *Black Rock*, the tests of validity espoused by these cases should be expressly discarded. Prompt and decisive action by Congress is mandatory if we are to retain a viable patent system.

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186. *Id.* at 373, 165 U.S.P.Q. at 612: It is particularly disturbing to see the "flash of genius" rhetoric of Cuno Eng'r Corp. v. Automatic Devices Corp., 314 U.S. 84, 51 U.S.P.Q. 272 (1941), which was discarded by the second sentence of section 103. *See* Harris, *Legislative Intent*, *supra* note 98, at 679.

187. 312 F. Supp. at 371, 165 U.S.P.Q. at 610. The Court listed 14 Eighth Circuit cases decided between 1966 and 1969 in which the patents were held invalid. *Id.* at 371 n.1, 165 U.S.P.Q. at 610 n.1.